IN THE

Supreme Court of the United States

October Term, 1960

No. 874

THE I. LEON CO., INC.,

Petitioner

v.

KENNETH REINER and FRANK A. KLAUS, Jr., d/b/a as THE KAYNAR COMPANY, and KAYNAR MFG. CO., INC.,

Respondents

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

HENRY L. BURNETT
Attorney for Petitioner
Post Office Address:
Office of the Post Office Attorney
19 West 44th Street
New York 36, N. Y.
Murray Hill 2-7808

Law Printing Corp., Inc., 70 Pine Street, N. Y. C. Worth 4-2992

INDEX TO BRIEF

	PAGE
Opinions Below	1
Jurisdiction	2
Questions Presented	3
Statutes Involved in This Case	5
Statement of Case	5
ARGUMENT:	
Plaintiffs Have Acquired a Complete Monopoly in the Sale of Two Piece Clips	10
Plaintiffs Compelled Transfer to Themselves of Competing Patent as Consideration for Settlement	11
No Prospect That Suit Patent Will Be Litigated in Any Other Circuit	12
Was the Act of 1952 a Mandate by Congress to the Courts to Adopt a "Relaxed Standard of Invention", and Did Congress Thereby Abrogate the Rules Laid Down by This Court for Determination of Validity and Construction of Patents, or Was the Act Merely Codification?	12
Did Congress, by the Act of 1952, Mandate "Commercial Success" as the Principal Premise for Finding Patentability?	12
Should the Fact That Plaintiffs Have an "Almost Complete Monopoly" in the "Two Piece Hair Curl Clip Field" Justify Sustaining the Suit Patent and Extending It to That Which the Suit Patent Did Not Teach?	28

PAGE

Did the Act of 1952 Give to the Court of Appeals the Right to Ignore Its Own Stated Rules as to "Commercial Success"? 33

Did Congress, by the Act of 1952, Mandate That the Courts Shall Not Determine Whether Alleged Inventions or Discoveries Are Within the Constitutional Provision as to the Issuance of Patents? 43

Will This Court Permit the Court of Appeals, Without Remand to the District Court, to Make Findings to Support a Reversal of the District Court, Where the District Court Not Only Failed to Find, But Refused to Sign, Such Findings When Submitted? 46

Conclusion 49

CASES CITED

Altoona Theatres v. Tri-Ergon Corp. (1935), 294 U. S. 477 ..... 13, 24, 25, 36

Atlantic Works v. Brady (1882), 107 U. S. 192 ... 17, 42, 43

Bassick Co. v. Hollingshead Co. (1936), 298 U. S. 415 ..... 14, 40

Bede v. Baker & English, Inc. (C. A., 6 Cir.), 274 F. 2d 833 17

Bobertz v. General Motors Corp'n (C. A., 6 Cir., 1955), 228 F. 2d 94 17

Borkland v. Pedersen, 244 F. 2d 501 18

Burr v. Duryee (1863), 68 U. S. (1 Wall.) 531 ... 41, 42, 45

PAGE

Cold Metal Products Co. v. Newport Steel Corp. (C. A., 6 Cir., 1955), 226 F. 2d 19 36

Consolidated Trimming Corp'n v. London, 239 F. 2d 33 17

Crest Specialty v. Trager, 341 U. S. 912 43

Dow Co. v. Halliburton Co. (1945), 324 U. S. 320 .. 14

E. J. Brooks Company v. Stoffel Seals Corp'n (C. A. 2 Cir., 1959), 266 F. 2d 841 13

Ferguson v. Moore-McCormack Lines (1957), 352 U. S. 521 48

Foxboro v. Taylor Instrument Companies (C. C. A., 2 Cir., 1946), 157 F. 2d 226 ..... 36, 37

Frances P. Norman and Frances P. Norman, d/b/a The Norman Company v. Leonard Lawrence, argued November 1, 1960, and decided December 21, 1960, C. A., 2d, October Term 1960, Docket No. 26043 ..... 19, 40

General Motors Corp. v. Estate Stove Co. (C. A., 6 Cir., 1953), 203 F. 2d 912 ..... 16, 17

Gotham Silk Hosiery Co. v. Artcraft Silk Hos. Mills (C. C. A., 3 Cir., 1945), 147 F. 2d 209 47

Grant v. Walker, 148 U. S. 547 42

Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp. (1950), 340 U. S. 147 ..12, 14, 15, 17, 18, 20, 43

Halliburton Co. v. Walker (1946), 329 U. S. 1 14

Hotchkiss v. Greenwood, 11 How. (52 U. S.) 248 ....13, 38

Hubshman v. Louis Keer Shoe Co. (C. C. A., 7 Cir., 1942), 129 F. 2d 137 47

PAGE

Interstate Rubber Prod. Corp. v. Radiator Specialty Co. (C. A., 4 Cir., 1954), 214 F. 2d 546 15

James v. Campbell (1881), 104 U. S. 356 41

Johnson v. United States (C. A., 5 Cir., 1958), 256 F. 2d 849 47

Judd v. Wasie (C. A., 8 Cir., 1954) 211 F. 2d 826 .. 48

Jungerson v. Ostby & Barton Co., 335 U. S. 560 ... 14, 18

Lincoln Co. v. Stewart-Warner Corp., 303 U. S. 545 41

Lyon v. Bausch & Lomb Optical Co., 224 F. 2d 530, certiorari denied 350 U. S. 911 ....13, 14, 15, 19, 39, 40

Paramount Corp. v. Tri-Ergon Corp. (1935), 294 U. S. 464 .....13, 34, 35, 36

Permutit Co. v. Graver Corp. (1931), 284 U. S. 52 .. 13

Randall Foundation v. Riddell (C. A., 9 Cir., 1957), 244 F. 2d 803 47

Sanford v. Kepner, 344 U. S. 13 19

Schriber Co. v. Cleveland Trust Co. (1938), 305 U. S. 47 14

Sonken-Galamba Corp. v. Atchison, T. & S. F. Ry. Co. (C. C. A., 8 Cir., 1942), 124 F. 2d 952, certiorari denied 315 U. S. 822 48

Talon, Inc. v. Union Slide Fastener, Inc. (C. A. 9 Cir.), 266 F. 2d 731 34

United States v. Oregon Med. Soc., 343 U. S. 326 ... 47

United States v. Yellow Cab Co., 338 U. S. 338 47

PAGE

Vermont Structural Slate Co. v. Tatko Bros. Slate Co. (C. A., 2 Cir., 1956), 233 F. 2d 9 15

Vincent v. Sun-Citrus Products Co. (C. A., 5 Cir., 1954), 215 F. 2d 305 15

Waialua Agricultural Co. v. Maneja (C. A., 9 Cir., 1954), 216 F. 2d 466 47

Wasserman v. Burgess & Blacher Co., 217 F. 2d 402 17

Western Electric Co. v. Ansonia Co., 114 U. S. 447 42

Westinghouse v. Boyden Power Brake Co. (1897), 170 U. S. 537 ..... 42, 45

Zoomar, Inc. v. Paillard Products, 258 F. 2d 527, certiorari denied 358 U. S. 908 ..... 13, 15

STATUTES CITED

28 U. S. C. §1254 3

Patent Act of 1952, 35 U. S. C. §103 ..3, 4, 5, 12, 13, 14, 15, 17, 18, 19, 21, 27, 31, 34, 36, 37, 38, 48, 49

28 U. S. C §1338 5

28 U. S. C. §§1291 and 1292 (4) 5

R. S. #4915, 35 U. S. C. §63 19

35 U. S. C. §112 ..... 27, 28

Rule 52 F. R. C. P. 46

AUTHORITIES CITED

PAGE

Webster's New International Dictionary, Second Edition, Copyright 1950 7

35 Journal of the Patent Office Society, #4, pages 233-238 15

Report by the Senate Committee on the Judiciary 16

INDEX TO APPENDICES

Appendix I i

Appendix II ix

Appendix III xxix

Appendix IV xxx

Appendix V xxxi

Appendix VI xxxiv

Appendix VII xxxvi

Appendix VIII xlii

Appendix IX xlv

Appendix X xlvii

Appendix XI xlviii

IN THE

Supreme Court of the United States

OCTOBER TERM, 1960

No. .....

THE I. LEON CO., INC.,

Petitioner,

v.

KENNETH REINER and FRANK A. KLAUS, JR., doing business as THE KAYNAR COMPANY, and KAYNAR MFG. CO., INC.,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

The I. Leon Co., Inc., your Petitioner, respectfully prays that a Writ of Certiorari be issued out of and under the Seal of this Court to review the Judgment of the United States Court of Appeals for the Second Circuit, entered on December 21, 1960, which, by a divided court, reversed a judgment of the United States District Court for the Eastern District of New York which had dismissed the Complaint of Respondents on the merits.

Opinions Below

The opinion of the United States District Court for the Eastern District of New York is reported at 163 F. Supp. 724, and also is printed in the Appendix to Appellants'

Brief (PA. 74a-103a).* That opinion also is reported at 118 U. S. Patents Quarterly 30.

The majority opinion of the Court of Appeals for the Second Circuit, reversing the judgment of the United States District Court for the Eastern District of New York, and the dissenting opinion of the Hon. Thomas W. Swan, have not appeared in the Federal Reporter at this writing. They are reported at 128 U. S. Patents Quarterly 25. A copy of that opinion appears in Appendix I (p. i.).

Jurisdiction

The decision of the Court of Appeals was filed December 21, 1960. A Petition for Rehearing, a copy of which appears as Appendix II (p. ix hereof), was duly filed on January 5, 1961. An Order, signed only by the judges who voted for the majority opinion, denying the Petition for Rehearing, a copy of which appears as Appendix III (p. xxix hereof), was made on January 9, 1961.

The Petition for Rehearing also was considered by the active judges of the Court of Appeals as a Petition for a Rehearing in banc. An order, dated January 18, 1961, denied that petition with the statement that the Hon. Charles E. Clark had voted to grant the Petition for a rehearing in banc. A copy of that Order appears as Appendix IV (p. xxx hereof).

---

* For purposes of clarity, the appellations, "Plaintiffs" and "Defendant", will be adhered to herein to designate, respectively, Respondents and Petitioner herein, who, respectively, were Appellants and Appellee before the Court of Appeals. Reference to the "Appendix to Appellants' Brief", copies of which are to be supplied by the Court of Appeals, will be indicated as "PA. a", the blank space being completed by the number of the page; in like manner, pages in the "Appendix to Appellee's Brief", copies of which likewise are to be supplied by the Court of Appeals, are indicated as "DA. b". Reference to Exhibits will be "P. Ex. ," followed by the identifying character, for exhibits submitted below by Plaintiffs, and "D. Ex. ," followed by the identifying character, for exhibits submitted below by Defendant.

The jurisdiction of this Court is invoked under the provisions of 28 U. S. C. §1254, Appendix V (p. xxxi hereof).

Questions Presented

1. Whether the position taken repeatedly by the Court of Appeals for the Second Circuit, that the Patent Act of 1952 was a mandate by Congress to the Courts to adopt a "relaxed standard of invention" with relation to and to recede from the rules laid down by this Court, is a correct interpretation of that Statute, or whether the rules laid down by this Court have not been abrogated by the enactment of the Act of 1952, and such enactment was merely codification of the rules in effect at the time of such enactment, as held by many of the Court of Appeals in other Circuits.

2. Whether Congress, by the Act of 1952, 35 U. S. C. §103, overruled, set aside and made of no further effect the rules heretofore laid down by this Court to govern the determination of the presence or absence of invention in matters of the validity of Letters Patent, and whether Congress thereby made "commercial success" the controlling premise to support the extension of an "almost complete monopoly" into a complete monopoly, as established by the Court of Appeals in the opinion below.

3. Whether this Court should not grant certiorari in a case where the Court of Appeals, admitting that Respondents already have an "almost complete monopoly" in the "two piece" hair curl clip field, makes that monopoly complete by enjoining the wholly different structure of Petitioner who apparently was the only competition with Respondents left after Respondents exacted assignment of a patent from the only other competitor of Respondents as consideration for a release from damages on a consent judgment of injunction.

4. Whether this Court should not grant certiorari in a case such as this, where the probability that the issue of validity will ever arise elsewhere than in the Second Circuit is so remote as to be substantially non-existent.

5. Whether the Act of 1952 annulled the previous rulings of this Court, that the monopoly of a patent must be circumscribed within the specific language of the patent claim, and thus has made it possible for the Court of Appeals below to ignore the failure of the claim held valid to include the specific features relied upon to sustain the claim as valid, or whether the rules laid down by this Court still remain in effect so that a Court may not "reissue" a claim for something not expressly included within the terms of such a claim.

6. Whether the Act of 1952 has indeed overruled the rule laid down by this Court, and thus that the Court of Appeals is correct in its statement, that it is not for the Courts to decide what discoveries, under the Constitution, shall promote the progress of science and the useful arts sufficiently to grant an exclusive right in an invention, or whether, under the rulings of this Court, it still remains the function and the duty of the Courts to determine whether an alleged invention has in fact satisfied the Constitutional requirement that an alleged discovery or invention has promoted the progress of science and the useful arts to support patentability.

7. Whether, in considering whether there is infringement, the Act of 1952 authorizes the Court to refuse comparison of the accused structure with the suit patent against the background of the same prior art over which the Court found the suit patent valid, or whether the Court may ignore such prior art and stretch the thus validated suit patent even to include as infringement elements of the prior art not present in the suit patent but used by the accused structure.

8. Whether this Court should permit the Court of Appeals, without a finding of fact by the District Court, the actual trier of the fact, and without remanding the case to the District Court for findings of fact, to reverse the decision of the District Court upon alleged facts which the District Court, listening to the witnesses, would not or did not find as fact.

Statutes Involved in This Case

The suit is for infringement of reissue patent No. Re. 23,163 (PA. 176a), hereinafter referred to as the "suit patent". Various defenses were asserted, including invalidity and non-infringement. The suit patent is based on an original application filed July 24, 1946. The original patent No. 2,459,452 (PA. 174a) issued January 18, 1949. The reissue application for the suit patent was filed July 12, 1949, and the suit patent issued November 1, 1949. The suit was commenced on March 3, 1953. Therefore, the Act of 1952 (Title 35, United States Code) governs this suit. The pertinent sections will be found in Appendix V (pp. xxxii-xxxiii hereof).

The District Court had jurisdiction of the suit for infringement of Letters Patent under 28 U. S. C. §1338 (Appendix V, p. xxxii). The Court of Appeals had jurisdiction of the appeal from the judgment of the District Court under 28 U. S. C. §§1291 and 1292(4), (Appendix V, pp. xxxi-xxxii).

Statement of Case

Before proceeding to state the case on the outlined questions, Counsel for Petitioner wishes to state he realizes the volume of the statement. But it is not loquaciousness. A story may serve to pinpoint Petitioner's justification.

A producer, quickly thumbing a script, said to the author, "Much too long. Give me a synopsis". When

the author presented a few-page synopsis, the producer again impatiently turned away, saying, "I'm much too busy. Give me a digest".

Not too much later, the author handed the producer this synopsis: "Hero: lieutenant. Heroine: his colonel's wife. Hero and heroine madly in love. Climax—they commit suicide".

"No good," spat the producer, "ANNA KARENINA, word for word".

The present case is not word for word any case in which this Court has heretofore denied certiorari. It is unique in that it is believed it will be apparent that the Court of Appeals has done its utmost to press this Court into considering this case. The Court below has done too many things for that purpose to omit any one of them from the synopsis to follow.

Plaintiffs sued Defendant, Petitioner herein, a New York corporation, in the United States District Court for the Eastern District of New York for alleged infringement. Plaintiffs, all of California, Respondents herein (who changed from the plaintiffs originally of record when suit commenced) consist of one of the patentees (herein sometimes referred to as "Plaintiff-patentee") and another doing business under a trade name, and a corporation. So far as we are concerned here, there is only one plaintiff. The individuals who do business under the trade name and the corporation substantially are one.

The suit patent was on a joint application. Plaintiff patentee became, by assignment, the sole owner of the suit patent. He, in turn, during the pendency of the suit, assigned the suit patent to the corporate Plaintiff. Before assignment to the corporation, and before the commencement of the suit, application had been filed for reissue upon which the suit patent was granted.

The suit patent deals with a small clamp for holding a curl of hair in place during the steps of "setting the hair", in beauty parlor parlance. Just like any clamp, a

pair of jaws 3 and 4 (Fig. 2, PA. 176a) are movable toward and away from each other. A spring 16 (called a tongue, col. 3, l. 8, or bow, col. 3, l. 27) acts to keep the jaws normally closed. The jaws have integral handle portions 13 and 14; by pressing the handles toward each other by means of one's fingers, the jaws are forced open against the action of the spring to receive or release a curl.

During the trial, much was made of the fact that clamp plates 1 and 2 (each plate including a jaw and a handle) were made of steel. Nothing to this effect appears in the specification of the suit patent. The spring is cut from one plate. At least one plate must have a bend to form a much discussed dihedral angle 12 (col. 2, l. 39). This is merely the geometrical name for the divergence at a bend in a plane piece of material.

In both the suit patent, and the accused structure (that is, the clamp made by Defendant), the plates rock with relation to each other only because the two plates diverge from each other where the dihedral angle of one plate rests and rocks upon a face of the other plate. Plaintiffs pointed out that this was not enough since the plates were free to slide with relation to each other (col. 2, ll. 20-24). The suit patentees (the applicants for the suit patent) formed projections 10 from one plate, and holes or openings 11 in the other plate. The suit patentees did not make a clear disclosure on that score. Judge Learned Hand remarked during the argument on his difficulty in understanding the unclear showing. The suit patentees also did not like "projection" and "hole", and sought further confusion by using the respective terms, "spur" (col. 2, l. 54) and "socket" (col. 2, l. 55). Webster's New International Dictionary, Second Edition, copyright 1950, defines "spur" as meaning many things. In mechanics, that authority says "spur" is short for "spur gear". No gears are involved here. Since the dictionary provides no definition fitting the part here considered, it would

appear that Plaintiffs must accept their own specific structure as being meant by "spur", and not something else.

But the suit patentees make it crystal clear, and it is obvious mechanically, that unless the sockets are immediately at the vertex of the dihedral angle, where the bend rests on the other plate, and the spurs on the other plate fit into the sockets, at the bend, their whole purpose is gone. They would not hold the plates against movement one with relation to the other.

Plaintiffs admitted that this still was not enough. So they formed spring or tongue 16 to pull the plates together. Spring 16 is formed by cutting a piece from one plate, bending that piece outwardly *away* from that plate, and then back toward that plate (Fig. 2) but never engaging that plate, but passing through a slot in that plate (Fig. 1), and then passing further along through a slot in the other plate so that a hook 17 (impossible to see in Fig. 2, but described at col. 3, ll. 12-14) at the end of the spring catches upon an offset edge 18 provided upon the second plate. The spring *pulls* the plates against each other, to hold the spurs seated in the sockets. It was admitted repeatedly during the trial by Counsel for Plaintiffs and by Plaintiffs' expert that, without that spring hooked to *pull* the two plates together, the plates would not, could not, remain together; the spurs and the sockets would have no function. If the hook were removed from the spring, there was nothing left.

One defense was invalidity. The Patent Office, during prosecution of the application for the original patent and the application for the reissue patent, cited as prior art a number of patents which established that the dihedral angle method of pivoting one plate upon another in a clamp, the cutting of a spring from one plate, and thus making what was termed a two piece clamp, and the engagement of that spring with the other plate to force the jaws to closed position, the provision of integral

handle sections to be engaged for forcing the jaws of the clamp plates apart, all were old. In many cases, the two plates were held firmly against separation without benefit of the spring; in some of these cases, means termed, in mechanical parlance, ears and trunnions, were used. The ears were formed as an integral part of one plate, and had small openings in them. The other plate had extending from it projections which were just as much spurs as those in the suit patent. The ends of those projections, termed "trunnions" in mechanical parlance, fitted into openings in the ears. Thus two purposes were served —this interengagement: formed the pivot for the two plates; kept the two plates from flying apart, regardless of presence or absence of the spring (see British patent to Turnor, 10,972 (PA. 182, D. Ex. H-16); Porter, 206,896 (PA. 188a); Cahn, 769,336 (PA. 190a); Halket, 1,387,978 PA. 192a), Atchley, 1,591,732 (PA. 194a)).

The accused structure differed from the suit patent. It did not use a spring in any way resembling that of the suit patent. The suit patent spring had to be anchored at its ends to pull the plates together, to hold the dihedral angle engaged against the face of the opposed plate, and to keep the spurs seated in their so-called sockets. Without the hooked spring in the suit patent structure, the plates would fly apart, and the spurs and the sockets would be without function. In the accused structure (which was in accordance with Schildt, 2,687,737 (opposite DA. 94b)), there were no sockets. A cut was formed centrally of one plate, leaving the plate intact at opposite sides of that cut (Fig. 3, see 36; also see D. Ex. ZZ, Appendix X, p. xlvi). Then two tabs 19 (Fig. 5), struck up from the other plate, fitted into that cut. Those tabs are provided with "barbs" as they were termed at the trial, formed by undercutting to define notches 21 (Fig. 5) which permit tabs 19, pushed through opening 36, to spring outwardly and *lock* the parts permanently together

(col. 3 of Schildt patent, ll. 17-26). Those barbs obviously hold the plates together in the same manner as the trunnions and ears of the prior art (see Lindsay, 2,031,377, PA. 198a, Fig. 2, flanges 4 fitted into notches 3; also see Montage, Appendix IX, p. xlv). The spring 17 in the Schildt patent takes no part, is unnecessary, to retain the plates against separation in the accused structure, just as in the prior art.

The spring of the accused structure, unlike the spring of the suit patent, was struck from one plate, passed *between* the plates (see Fig. 2, opposite DA. 94b), through the opening 34 in the *handle* of the other plate, formed for the reception of the barbs, and then extended over to *push down* upon, not to pull against, a hump on the other plate. The free end of the spring did not hook on to anything. Indeed it had to be free to slide over the face upon which it pressed, just as did the springs in Cahn, 769,336 (PA. 190a) and Turnor (British) 10,972 (PA. 182a, D. Ex. H (16)). The spring of the suit patent structure had to be *anchored* at *both* ends, according to the teaching of the suit patent. Destroying the spring in the accused structure or in these prior art patents did not free the plates from each other.

The patent was held invalid by the District Court as involving no invention over, and as constituting an aggregation of old elements shown, in the prior art. The District Court held that, if valid, the patent would be infringed by the accused structure.

ARGUMENT

Plaintiffs Have Acquired a Complete Monopoly in the Sale of Two Piece Clips

Defendant, before the Court of Appeals, did not find it necessary to expound that which, under Judge Byers' decision in the District Court, was there irrelevant to the considerations of validity and infringement. But Judge

Learned Hand has injected a factor of new importance here. He finds, in his decision, that Plaintiffs "had established an almost "complete monopoly of the 'two-piece clips in the market'." Then Judge Hand, by his decision against Defendant, grants Plaintiffs a *complete* monopoly in this field.

Plaintiffs Compelled Transfer to Themselves of Competing Patent as Consideration for Settlement

For Defendant seems to have been the only one who has braved the expenses which must be incurred in defending a patent suit involving the suit patent (Appendix XI, p. Li). Another suit had been brought involving an alleged infringer, one Solo Products Corporation. Solo attempted to get jurisdiction over Plaintiffs in the Second Circuit by a declaratory judgment action in United States District Court for the Eastern District of New York, Civil Action No. 9785. Plaintiffs brought suit in the United States District Court for the Southern District of California, Civil Action No. 9357C, where Solo was forced to defend. After consideration maneuvering, Solo Products Corporation, finding the expense too great (Appendix XI, p. L), gave up without a plenary trial, and consented to a judgment of injunction against its structure for which it had obtained Letters Patent No. 2,464,739, issued March 15, 1949. As a condition for settlement of that suit, Plaintiffs here compelled Solo to assign to them Patent No. 2,464,739 (Appendix XI, pp. Liii, Lv). Thus Plaintiffs cut off substantially all competition against them not only during the life of the suit patent but also by means of the Solo patent. Indeed, even if the suit patent be held invalid, Plaintiffs still are in a position to make representations to the trade as to their patent-protected two-piece clips, since the Solo patent has not been adjudicated in any manner.

No Prospect That Suit Patent Will Be Litigated in Any Other Circuit

It is well recognized that the Second Circuit is the most active circuit in patent litigation. From the facts just stated, there appears to be no present prospect that any one in an other Circuit will be sued by Plaintiffs to subject the suit patent to further scrutiny. The prospects, that the suit patent ever will be subjected to a test as to its validity in any other Circuit, are even less remote than they were in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.* (1950), 340 U. S. 147 (hereinafter referred to as the *Great A. & P.* Case), where petition for certiorari was granted because of this likelihood that the patent would not be subject to litigation in another Circuit. With final determination of the present suit, Plaintiffs will have disposed of their only competitor in the field of two-piece hair clips. Thus there appears to be not the slightest possibility that validity of the suit patent ever will be tested in any other Circuit.

Was the Act of 1952 a Mandate by Congress to the Courts to Adopt a "Relaxed Standard of Invention", and Did Congress Thereby Abrogate the Rules Laid Down by This Court for Determination of Validity and Construction of Patents, or Was the Act Merely Codification?

Did Congress, by the Act of 1952, Mandate "Commercial Success" as the Principal Premise for Finding Patentability?

Obviously, there is nothing in the Act of 1952 which speaks in terms to make "commercial success" the prime premise for a finding of patentability. Yet the decision below makes "commercial success" the major premise. There is no consideration of "new result" from the association of elements. There is no mention of any relationship between any new association of elements defined by

the patent claim and commercial success. Yet, in the same Circuit, Chief Judge Clark, in *E. J. Brooks Company* v. *Stoffel Seals Corp'n* (C. A., 2 Cir., 1959), 266 F. 2d 841, 843, 844, pointed out that commercial success had not premised invention in the same Circuit, in *Zoomar, Inc.* v. *Paillard Products,* 258 F. 2d 527, certiorari denied 358 U. S. 908, and then proceeded to hold invalid the patent in the case he was deciding, despite an impressive history of development and commercial success set forth in the dissenting opinion of Judge Lumbard. Judge Clark pointed out further (266 F. 2d 844, footnote) many cases in many different circuits which had held that 35 U. S. C. §103 had not changed the rule of law.

A study of the digest of cases before the Supreme Court since enactment of the Act of 1952, insofar as those digests are correct, fails to disclose any case before this Court, except where petition for certiorari filed was denied, which considered the question presented as to the provision of that Act, 35 U. S. C. §103, in the majority opinion below. Judge Learned Hand repeatedly has asserted, as he asserts in his opinion below, despite opposition not only in other Circuits but even within his own Court, that the Act of 1952 has thrown aside the doctrines which had been announced by this Court in the past number of years, and that Congress has issued a mandate to the Courts to revert to doctrines not as found in decisions in recent years, but a "relaxed" doctrine of invention said to be found in *Hotchkiss* v. *Greenwood*, 11 How. (52 U. S.) 248, 266. *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530 (herein referred to as the *Bausch & Lomb* Case), certiorari denied 350 U. S. 911. Thus, by one swoop, Judge Learned Hand says that Congress has overruled and made of no further effect authorities such as *Permutit Co.* v. *Graver Corp.* (1931), 284 U. S. 52; *Altoona Theatres* v. *Tri-Ergon Corp.* (1935), 294 U. S. 477; *Paramount Corp.* v. *Tri-Ergon Corp.* (1935), 294 U. S. 464;

Bassick Co. v. *Hollingshead Co.* (1936), 298 U. S. 415; *Dow Co.* v. *Halliburton Co.* (1945), 324 U. S. 320; *Halliburton Co.* v. *Walker* (1946), 329 U. S. 1; *Schriber Co.* v. *Cleveland Trust Co.* (1938), 305 U. S. 47, and finally, and it is believed most importantly, the *Great A. & P.* Case, 340 U. S. 147, decided in 1950. This last is important since the District Court, in reaching its conclusion that the suit patent was invalid, considered this *Great A. & P.* Case to support his conclusions as to invalidity. The Court of Appeals, on the other hand, in reversing the District Court, made no direct reference to the doctrines set forth in the *Great A. & P.* Case, but, by explicit words, demonstrated that the Court of Appeals considered that the pronouncements of that case no longer were in effect. The Court of Appeals referred to its own decision, in the *Bausch & Lomb* Case, 224 F. 2d 530, and to the dissent of Mr. Justice Jackson, in *Jungerson* v. *Ostby & Barton Co.*, 335 U. S. 560, 572, which dissent had referred favorably to the dissent of Judge Learned Hand in the decision of the Court of Appeals there.

The Court of Appeals below reads into the Act of 1952,—and this appears specifically in the language in the opinion below,— a statutory command from Congress that the Courts relax the requirements for patentability, requirements which had been announced as recently as the *Great A. & P.* Case, in 1950. With this major premise, the Court of Appeals, over the dissenting vote of the Hon. Thomas W. Swan, considered as the next important premise the alleged "commercial success" of the suit patent structure. Finally, as apparently the least important premise, the Court of Appeals came up with its own "finding" as to the saving of metal in the process of making the clamp of the suit patent.

That the Act of 1952 contained no such mandate, but was merely a codification of the law as it had been announced prior to that time by this Court and by the different Courts of the United States, has been held in vari-

ous Circuits. Indeed, the Second Circuit itself lacks unanimity on this score. Judge Frank, in a footnote to *Vermont Structural Slate Co.* v. *Tatko Bros. Slate Co.* (C. A., 2 Cir., 1956), 233 F. 2d 9, 11, expressed his "serious doubts about the correctness of that ruling" in the *Bausch & Lomb* Case. Chief Judge Clark said that Second Circuit had "not definitively ruled on the question" and further rejected considerable "commercial success" as a basis "for a strong inference of originality". *Zoomar, Inc.* v. *Paillard Products* (C. A., 2 Cir., 1958), 258 F. 2d 527, 530.

In *Interstate Rubber Prod. Corp.* v. *Radiator Specialty Co.* (C. A., 4 Cir., 1954), 214 F. 2d 546, 548, 549, the Court found that the rule of this Court in the *Great A. & P.* Case, 340 U. S. 147, "was not changed by the revision of the patent statute by Congress in 1952", that "As stated in the Senate and House Reports during the enactment of the statute by Congress and in recent decisions of the courts, the provisions of §103 merely codified the law laid down by the courts during the past hundred years, and were added to the statute for the purposes of uniformity and definiteness. See Stanley Works v. Rockwell Mfg. Co., 3 cir., 203 F. 2d 846; General Motors Corp. v. Estate Stove Co., 6 cir., 203 F. 2d 912."

In *Vincent* v. *Sun-Citrus Products Co.* (C. A., 5 Cir., 1954), 215 F. 2d 305, 315, 316, the Court pointed out that it was in agreement with the statement in 35 Journal of the Patent Office Society, #4, pages 233, 234, 235, 236, 238, that the Patent Act of 1952 "is essentially a codification of the law as it has been enunciated by the Courts for more than 100 years"; that "The legislative intent in enacting this section of the Act appears to have been to codify the law for its stabilizing effect * * *. By legislating as to the subject matter of patentability and at the same time not seeing fit to legislate a criteria or test for the determination of what would be obvious to one having

ordinary skill in the art, the many prior holdings pertinent to this point of law probably will be held to have been impliedly written into the new statute."

In *General Motors Corp.* v. *Estate Stove Co.* (C. A., 6 Cir., 1953), 203 F. 2d 912, 915, the Court said that it failed to see the basis upon which the conclusion can be drawn that the Patent Act of 1952 provides a new test of patentability, that the legislative history appeared to afford no support for this position. The Court then quoted from the report by the Senate Committee on the Judiciary, which report, it said, repeated in substance the House Report, that

> " 'Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the courts and in writings. Section 103 states this requirement in the title. It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102. If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented.
>
> " 'That provision paraphrases language which has often been used in decisions of the courts, and the section is added to the statute for uniformity and definiteness.' Senate Report No. 1979, June 27, 1952 (To accompany H. R. 7794). See House

Report No. 1923, May 12, 1952 (To accompany H. R. 7794).

"The Revision Notes in the Appendix to the Senate Report further state:

"'There is no provision corresponding to the first sentence (of Sec. 103) explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850.'"

The astounding thing is the failure of any word in these Congressional Reports to define any mandate for a change.

The Court of Appeals for the First Circuit, in *Wasserman* v. *Burgess & Blacher Co.*, 217 F. 2d 402, 404, said that Congress, by passage of the Patent Act of 1952 "merely codified the existing decisional law. 35 U. S. C. §103," citing, as such decisional law, the *Great A. & P.* Case, 340 U. S. 147, and *Atlantic Works* v. *Brady* (1882), 107 U. S. 192, 200.

In *Bobertz* v. *General Motors Corp'n* (C. A., 6 Cir., 1955), 228 F. 2d 94, 99, Judge Martin cited with approval a previous statement by Judge McAllister, in the *Estate Stove* Case, 203 F. 2d 912, 917, 918, that the principle stated in the *Great A. & P.* Case was not modified by the Patent Act of 1952.

As late as February 1, 1960, this same Court, in *Bede* v. *Baker & English, Inc.* (C. A., 6 Cir.), 274 F. 2d 833, 839, considered the rule of the *Great A. & P.* Case as controlling.

In *Consolidated Trimming Corp'n* v. *Loudon*, 239 F. 2d 33, 36, the Court of Appeals for the District of Columbia Circuit took cognizance of the argument as to the effect of 35 U. S. C. §103 on the *Great A. & P.* Case, cited decisions to show that other Circuits had held that there was no

difference, and then held specifically that the *Great A. & P.* decision was controlling.

In *Borkland* v. *Pedersen*, 244 F. 2d 501, 503, 504, the Court of Appeals for the Seventh Circuit rejected the argument that the Patent Act of 1952 had lowered the standard of invention.

This direct conflict among the Circuits in the interpretation of the Act of 1952, present even among the judges of the Court of Appeals for the Second Circuit, requires, it is submitted, resolution by this Court.

It should be noted that, on the Petition for Rehearing *en banc* (Appendices II (p. ix) and IV (p. xxx)), Judge Clark voted for a rehearing *en banc*. Such a rehearing *en banc* would have excluded from the consideration of this case, Judges Learned Hand and Harold R. Medina, the majority judges below, both of whom are senior judges. Despite the denial of the Petition for Rehearing *en banc*, it still remains a fact that the bench which decided the case below was comprised only of senior judges.

Judge Learned Hand, in his decision below, adverts to the dissenting opinion of Mr. Justice Jackson, in *Jungerson* v. *Ostby & Barton Co.*, 335 U. S. 560, where Judge Hand had dissented where the Court of Appeals for the Second Circuit had held a patent invalid despite overwhelming commercial success. Judge Learned Hand's decision in the present case apparently is deducing that the Act of 1952 rejected this Court's majority opinion in the *Jungerson* Case, and affirmed his dissenting opinion which had been rejected by this Court. Unluckily, Defendant has been caught in this cross-fire as Judge Learned Hand seeks to reinstate his position in the *Jungerson* Case as the law of the land, or, at least, as the law in the Second Circuit in a case of minuscule advance over the art. His language in the instant case seems to state a challenge to this Court to gainsay that the law is as stated in the *Jungerson* Case, and not the *Great A.*

& P. Case, as to commercial success as a sufficient major premise upon which to support patentability.

Certainly this sharp divergence as to the effect of 35 U. S. C. §103, of the Act of 1952, is just as important to establish the necessity for resolution by this Court for the proper administration of patent law as was the question in *Sanford* v. *Kepner*, 344 U. S. 13, where the question was on a narrow issue, in a proceeding under R. S. §4915, 35 U. S. C. §63.

Obviously, the repeated assertions of the rule of the *Bausch & Lomb* Case in other cases in the Second Circuit, which rule Judge Clark says has never been adopted, is the assertion of a rule which has its greatest effect in the Circuit which has the greatest amount of patent business of any circuit in the United States. Thus, in effect, Judge Learned Hand's repeated assertions of the doctrine he announced in the *Bausch & Lomb* Case, that the Act of 1952 mandated a relaxation of the rules of patentability, and, as here, established "commercial success" as the major premise for the conclusion of invention, has made that rule virtually the rule in a major number of suits involving validity of patents in the United States, apparently without fear of reversal. Thus, this rule is accepted as binding in the case here, as in an accompanying case decided almost at the same time, the case of *Frances P. Norman and Frances P. Norman, d/b/a The Norman Company* v. *Leonard Lawrence*, argued November 1, 1960, and decided December 21, 1960, before the Court of Appeals for the Second Circuit, October Term, 1960, Docket No. 26043. It is interesting that these two decisions were published, side by side, on the front page of the New York Law Journal, of February 23, 1961, with a caption which reads as follows:

"PATENTS—INVENTION—COMBINATION OF OLD ELEMENTS—NEED FOR AND SALES OF NEW DEVICE—PAD FOR EARRINGS AND CLAMP FOR CURLS

"Invention is not to be measured by the size and complexity of the product. A pad used to hold earrings in place and a clamp used to maintain 'formed curls' in a woman's hair are patentable, though they are combinations of old elements, if, as the statutory definition requires, their new concourse would not 'have been obvious at the time the invention was made to a person having ordinary skill in the art.' That test is met if the device fills a need that has long existed and that others have attempted to supply and if the volume of its sales shows wide acceptance of it in place of what has gone before."

The effect of this publication has been repeated inquiries from various attorneys, as to whether Defendant here will petition this Court for certiorari.

Thus, for the Second Circuit, the decision in the case here has been published as the final authority on these matters, that "commercial success" is the criterion for patentability.

Judge Learned Hand, in his opinion, must be considered to have pronounced an even more revolutionary doctrine, that it "is not for us to decide what 'discoveries' shall 'promote the progress of science and the useful arts' sufficiently to grant any 'exclusive right' of inventors * * *." Thus, Judge Hand denies that the Courts are vested with the prerogative of determining constitutionality. More importantly, it appears clearly that Judge Hand is rejecting the express words of Mr. Justice Douglas, in the *Great A. & P.* Case, 340 U. S. 147, 154. Judge Hand does not say who is so to decide. He does not point to any criterion laid down by Congress, except 35 U. S. C.

§103. But that obviously has, and may have, no significant guidepost. It says nothing about "commercial success" or "saving of material". Then who is to determine? The inventor himself? The expert who testifies for one side or the other? Or are the Commissioner of Patents and his Examiners to be the final authority? As to this, Judge Hand says that the Court is requested "to surmise what was the range of ingenuity of a person 'having ordinary skill' in an 'art' * * *." Then he says that, as to such art, "we (that is, his Court) are totally unfamiliar * * *." His consideration then effectively denies the exact words of 35 U. S. C. §103, which speaks of "*the time the invention was made*", for he goes along to consider, not the condition of skill at the time the invention here allegedly was made, but by having recourse to the *earlier* work in the art.

Judge Hand then further confounds the system by which Courts have ruled upon validity of patents, by arguing that

> "To judge on our own that this or that new assembly of old factors was, or was not, 'obvious' is to substitute our ignorance for the acquaintance with the subject of those who were familiar with it."

And who are these "who are familiar with it"? He does not say.

After his full consideration of commercial success, what appears to be the only structural element for novelty is revealed:

> "* * * economy of production is as valid a basis for invention as foresight in the disclosure of new means. In the case at bar the saving of material as compared to anything that had preceded, was very great indeed; the existing devices at once yielded to Reiner's disclosure; his was an answer to the 'long-felt want.'"

The decision speaks of economy of material and labor. No finding of commercial success was made by the District Court. No finding as to economy of material, or its effect, was made by the District Court. Yet that Court listened carefully to Plaintiffs' case in that respect (PA. 165a). There is no disclosure or discussion of minimum either of material or of labor in the suit patent. It was repeatedly admitted during the trial, both by the Attorneys for the Plaintiffs and by the expert witness for the Plaintiffs, that the suit patent disclosed no process of manufacture; did not in any way limit the shape or size of the article. There was no basis for limitation of any patent claim by any such factor. Repeatedly it appears, and the claim speaks for itself, that there is no such limitation in any claim, including claim 3, the claim held valid by the Court Appeals in reversing Judge Byers.

A factor of importance has developed since the mandate of the Court of Appeals went down to the District Court. Plaintiffs submitted a proposed judgment on mandate, a copy of which appears in Appendix VI (p. xxxiv). At the same time, Plaintiffs submitted proposed findings of fact and conclusions of law, a copy of which appears in Appendix VII (p. xxxvi). In both of these papers. Plaintiffs sought to have Judge Byers, in the District Court, make as findings these matters which he had not found after trial, either in opinion (PA. 74a) or in judgment (PA. 102a). Defendant countered with a proposed Judgment, a copy of which appears in Appendix VIII (p. xlii). Judge Byers approved and signed only the Judgment presented by Defendant.

Indeed, the majority opinion in the Court of Appeals ignores the express statements by Plaintiff-patentee himself, who testified that not only was the structure of the suit patent included within his so-called invention; he also included within his patent any structure which had projections at the side edges of the plate which projections, when bent in (as in Lindsay, see Montage, Appendix IX,

p. XLV) would engage in openings in parts on the other plate of the clamp (DA. 63b). This in itself necessarily includes flanges 17 of Jones (PA. 200a) and the lugs of Lindsay. This last is of very great importance because of the argument by Judge Hand, in finding patentability, that there was saving of material. Such lateral projections destroy any such alleged saving.

The suit patent does not consider at all the method of forming the clamp plates. To save metal, the spurs and sockets *must* be *inboard* from the side edges of the plates. The edges of the plates *must* be parallel to each other. The suit patent has nothing to do with any specific shaping of the plates; yet obviously it is essential (P. Ex. 25). Indeed, there is not the slightest definition in claim 3 requiring the side edges of the plates to be parallel to each other. So far as claim language is concerned, those edges could be the same as in Boxer, 2,289,749 (PA. 182a, D. Ex. H-8), or British patent to Turnor, 10,972 (PA. 182a, D. Ex. H-16), or Porter, 206,896 (PA. 188a), or Cahn, 769,336 (PA. 190a), or Halket, 1,387,978 (PA. 192a), or Atchley, 1,591,732 (PA. 194a), or Lindsay, 2,031,377 (PA. 198a), or Jones, 2,133,145 (PA. 200a). All of these would be within the bounds of claim 3. Each of those structures would save as much metal as the suit patent claim structure. May this complete absence of an essential ingredient be ignored? Claim 3, which Judge Learned Hand held valid, is as follows:

> "In a clamp for clamping a flat curl on one's head, the combination of two superposed elongated plates extending longitudinally with each other, having integral handles and clamping jaws, said plates having correlated means integral respectively with said plates, including spur means integral with one of said plates, and socket means on the other plate receiving the spur means, and cooperating therewith to hold said plates against shifting relatively to each other, and forming a rocking connection be-

> tween said plates, one of said plates having a resilient integral extension of bow-form struck from its material and extending around the axis of said rocking connection, engaging the other plate and constantly urging the jaws toward their closed position."

The rule of this Court referred to had been stated by Mr. Justice Stone, in *Altoona Theatres* v. *Tri-Ergon Corp.* (1935), 294 U. S. 477, 482, 487. He considered an argument made for patentability based upon the location of a fly wheel with relation to a two-toothed cylinder. Mr. Justice Stone pointed out, in declaring the claims invalid, that

> "In any case, the claims call only for the fly wheel located upon the shaft or in association with the cylinder. No particular location is mentioned."

Just as in that case, so here, the Court of Appeals "made no examination of its separate claims, but treated the patent throughout as though it were a" certain combination, "although nowhere in the patent is any such combination claimed". Here, the Court of Appeals has made much of a saving of material. Yet that element is not even mentioned in the objects of invention, not even described in the specification, and not included in any limitation of the claim, of the suit patent. As Mr. Justice Stone continued, so here:

> "The patent thus upheld is one which was neither claimed nor granted."

Claim 3 is violative of the rules laid down by this Court on many grounds. A dihedral angle was much discussed during the trial, and in the suit patent itself. That angle 12 (Fig. 2, PA. 176a), formed in one plate and resting its vertex upon the surface of the other plate,

is essential. Without it, the plates could not rock on each other to separate the jaws. Furthermore, the spurs and the openings must be located at the dihedral angle, at the position of rocking on the other plate. Without that coincidence, the spurs and openings could not function to hold the plates against sliding apart, the reason given for the spurs and openings by the Court of Appeals. Yet claim 3 has no specification of these most essential requirements. The dihedral angle is not even mentioned in claim 3. The location of the spurs and sockets at the dihedral angle is not mentioned in claim 3. The words of claim 3 do not differentiate from a prior art structure such as Cahn, 769,336 (PA. 190a) considered by Judge Byers to reach his conclusion of invalidity. That patent has jaws and handles, but no dihedral angle. The same is true in: Halket, 1,387,978 (PA. 192a) has plates, jaws, handles, but no dihedral angle for one plate to rest upon the surface of another plate: Atchley, 1,591,732 (PA. 194a) has plates, jaws, and handles, but no dihedral angle; Turnor, British Patent No. 10,972 (PA. 182a, D. Ex. H-16) has jaws, handles, but no dihedral angle. All of these patents have integral springs, and are "two-piece clips". This complete failure of definition in the claim fails to describe the essential ingredients for the alleged saving of metal upon which the Court of Appeals based its decision, and thus comes to the fault in claim language condemned by Mr. Justice Stone in the *Altoona* case.

The Court of Appeals, in attempting to argue out of this difficulty, says that

> "A claim must of course read upon the specifications, but the specifications, unless so declared, are only an example of what the claim is intended to cover * * *",

and thus leaves the matter wholly up in the air. Does the Court of Appeals mean that a claim does not have to

include the limitation of the structure necessary for the "new" result, the saving of metal upon which that Court founded its reversal of Judge Byers?

Obviously, there should be something in claim 3, other than the words "spur means" and "socket means", to define the alleged invention away from "side flanges, 17" of Jones, 2,133,145, which, according to the Court of Appeals, "requires the upper member to be different from the lower, and the use of more metal than the spur and socket device of the patent in suit." Obviously, of the two plates of the suit patent, the upper member 1 must be different from the lower member 2. A glance at Fig. 2 of the suit patent (PA. 176a) is all one needs to see that. What is the recited difference? The spur and sockets, according to Plaintiff-patentee, may be at the very edge of the plates, just as the members Jones calls his side figures 17. Although the spurs and stockets must be at the dihedral angle, and the dihedral angle on one plate must rest upon the other plate, and the spurs and sockets must be completely inboard from the edges of the plate, to attain any saving of material referred to by the Court of Appeals, and to avoid the prior art, none of this is defined in claim 3.

Claim 3, without any amendment such as that which the Court of Appeals attempts to import into it, reads word-for-word upon prior art patents such as Cahn, 769,336 (PA. 190a). Judge Byers found specifically (PA. 93a),—and that finding has not been declared by the Court of Appeals to be clearly erroneous,—"ears, spurs, sockets, etc. are mere matters of mechanical adjustment and the substitution of one for the other does not involve patentable invention." Thus whether the hinging means be the ears and trunnions of patents such as Cahn, or the spurs and sockets of the suit patent, they create no patentable invention. The ears receive the trunnions, as the sockets receive the spurs of the claim. In Cahn, the

ears and trunnions form a rocking connection for the plates; a spring of bow-form is struck from the material of one plate, extends around the axis and engages the other plate and constantly urges the jaws toward closed position. There is not defined in that claim a single differentiation from Cahn.

What the Court of Appeals attempts to find in claim 3 cannot even be found in the specification. It had to be found, not in the findings by the District Court, but in something wholly outside the specifications, outside the claim.

Certainly no argument as to "relaxation of standard of invention", allegedly arising from 35 U. S. C. §103, can be extended to change the interpretation of 35 U. S. C. §112 (p. xxxiii), so many times reiterated by this Court, as to the requirements for specific claiming. Since, as it otherwise appears, claim 3 otherwise fails to define invention, that claim cannot "be aided by reading into it parts of a "specification which does not even exist, and indeed parts "which the patentees failed to include" either in that claim, or in the supporting specification, in the words of Mr. Justice Stone.

Firstly, patentability has been founded upon economy of labor and material, not specified. Secondly, to save material, there must be no projections from the side edges. The spurs or prongs could not be positioned just anywhere. But the claim specifies no location. It includes the Lindsay structure, which has projections at the side edges. The Court distinguished the claim from Jones, 2,133,145 (P.A. 200a), because Jones had flanges 17 at the side edges of one plate, which, according to Judge Hand, required "the upper member to be different from the lower, and the use of more metal than the spur and socket device of the patent in suit."

If member 17 were cut inside from the edges of the plate, apparently that would have anticipated claim 3. But

the Plaintiff-patentee refused to exclude even the type of flange of Jones from the scope of his claim. The difference, the Court says, is the spurs and sockets. Yet claim 3 has no such requirement, that the spurs and sockets be inboard from the edge of the plates. This is the type of positioning to which Mr. Justice Stone referred when he found the claims there failed to define that which the Court of Appeals asserted to be the point of patentability. Is this not an annulment of 35 U. S. C. §112, which, in effect, was the rule Mr. Justice Stone was applying?

The Court of Appeals, in casting aside Jones, 2,133,145 (PA. 200a), fails to consider a pivot structure which appears in the Australian patent to Woodfull, 118,458 (PA. 182a, D. Ex. H-13). In that patent, we have the *inboard* flange 5 (Fig. 4; col. 3, l. 23 of the specification), as much a spur as in the suit patent, engaging in a socket or recess 6 (col. 3, l. 25) to keep the jaws from sliding apart. If Jones had been made in this manner, with inboard flanges 5 and recesses 6 eliminating the side flanges of Jones, would they be different structurally from or function any differently than the spurs and sockets of the suit patent? Thus even if claim 3 had not failed to define that the spurs and sockets are *inboard* from the edges of the plates, Woodfull shows that there is nothing in that method of construction to support novelty.

Should the Fact That Plaintiffs Have an "Almost Complete Monopoly" in the "Two Piece Hair Curl Clip Field" Justify Sustaining the Suit Patent and Extending It to That Which the Suit Patent Did Not Teach?

May the Court of Appeals disregard the prior art in finding infringement to extend the monopoly? The Court of Appeals made its own finding, that Plaintiffs had a virtual monopoly. With that as a major premise, the Court proceeded to find the patent valid, and then to find

it infringed by the accused structure. Before the Court of Appeals, Defendant pointed out wherein the accused structure followed not the suit patent, but the prior art. To substantiate that position, Defendant considered Jones, 2,133,145 (PA. 200a), mentioned by the District Court, but not considered as the main basis for its holding of invalidity. In Jones, two plates 10 and 11 were pivoted, one upon the other, substantially in the same manner as in the suit patent, that is, an angled section of one plate 11 pivots and rocks upon a portion of the other plate 10.

Jones has more than these mere angularities; his spring 22 passes through openings 13 in the handles 12 and 18 of the plates. The spring passes around the pivot and engages against the plates on their jaw sides (see Fig. 4), as in the accused structure, to press the jaws together. The difference between Jones and the suit patent structure, the Court of Appeals said, in overruling Judge Byers' decision, was in that the plates in Jones were held against lateral movement by upstanding flange 17 on one plate, and in a difference in the springs of the suit patent and Jones. The accused structure, the Court of Appeals said, was different from the suit patent structure, yet was held to infringe the suit patent. The Court of Appeals mentioned a difference in the springs of the accused structure and the suit patent. The Court of Appeals did not mention that the spring of the accused structure, which admittedly was not the same as the suit patent, followed Jones. It is interesting that when Defendant brought its accused structure on the market, Plaintiffs changed their spring structure from acrobatically hooking the spring by reaching through the "crotch", to follow Defendant's accused structure just as Defendant followed the prior art.

The Court of Appeals made no mention of the fact that the barbs of the accused structure followed the ear and trunnion constructions of the prior art, in holding the

plates permanently together, and had no need for the spring for any such purpose, an essential condition in the suit patent.

The Montage (Appendix IX, p. XLV) shows the relationship by which the patents to Lindsay, 2,031,377 (PA. 198a), and Jones, 2,133,145 (PA. 200a), lead to the structure of the suit patent and were the source of the structure of the accused structure. In the Montage, Lindsay is shown with its original spring, a separate member riveted to the handle of one plate and pressing against the handle portion of the other plate to force the jaws closed. Ears 4 (PA. 198a) hold the plates together in Lindsay. Their teaching for the production of the barbs of the accused structure is obvious. These ears are at the side edges of the plates, and turn inwardly and engage at the bend of the dihedral angle pivot to hold the parts together. Note the manner (Fig. 2) that these ears (or flanges, as they are named in this patent) engage in notches 3 to produce the identical retention and pivoting functions of the barbs and sockets of the accused structure. The barbs of the accused structure, with their inturned engaging ledges, follow Lindsay's flanges; they are not related to the almost invisible spurs and sockets of the suit patent. The barbs on one plate of the accused structure turn outwardly and engage over the other plate at the bend of the dihedral angle, just as the inturned ears of Lindsay so engage. Now if a hole be cut in the handle of Lindsay as a hole was cut in Jones, for his spring, and the spring be extended through that hole to engage upon the plate beyond the pivot as it engages in Jones, the effective accused structure is produced.

Judge Learned Hand did not mention Lindsay. Yet the Plaintiff-patentee,—and who should be able to speak more authoritatively regarding his invention,—says (DA. 63b) that even if his spurs are bent up from portions at the side edges of the plates, if they engage openings in the other plate,—and he does not limit himself against

openings in ears, or in slots as in Lindsay,—such structure is also his invention.

Thus, Defendant cannot understand what Judge Learned Hand means, as to the Act of 1952. If the suit patent is valid over the Jones and Lindsay patents, what has the accused structure derived from claim 3 which the suit patent did not derive from these two prior art patents? The accused structure does not use the structure of the suit patent, or anything close thereto. The accused structure is substantially the opposite of the suit patent. Its spring does not have the functions of the suit patent spring. Its barbs have no correlative in the suit patent. Its spring is cut from a handle, passes through a hole in the other handle, and presses against and moves freely over a jaw member to *press it down* against the plate from which the spring is cut. In the suit patent, the spring is cut from one plate but does not, cannot, pass through a hole in a handle, and *hooks* and is anchored upon an edge of the other plate, may not move with relation to that plate, and *must pull* against that edge; if it does not hook, and does not pull, there is no clamp; the plates fall apart. In the accused structure, the spring does not hook the parts together; the barbs at the pivot, as the trunnions in the old art, hold the parts together.

The Court of Appeals made much of an alleged lapse of thirteen years between the appearance of what it finds to be the first clamp, and the clip of the suit patent. Completely ignored was the fact that included in those thirteen years were, of course, the years from 1939 to 1946 (Appendix XI, p. Liv). The District Court, which heard the witnesses, made no finding as to any problem here as to the length of time of development. Even if it had not been mentioned in the record, it is too well known to require specific proof that in these war years it was a criminal act to use strategic metals for any civilian purpose, even one as important as the dressing of the hair of women. Plaintiff-patentee clearly admitted that he began

the development of the suit patent structure immediately as he found himself without war work, and in possession of the machinery and the know-how which he then used to make the clip of the suit patent. These are the progressive die operations, multiple steps to work metal to produce articles of many sizes, which were developed to a high state of proficiency during the war. Plaintiff-patentee stated, without quibble, that they went into the pin curl business because "• • • we were interested in obtaining a post-war product that would be utilizing the manufacturing facilities and techniques and know-how that we had developed in the prior two years of operation" (DA. 56b), that they had before them as guides many different clips, including the Colanite clip produced by the Petitioner-Defendant (DA. 57b-58b), thus contradicting the "findings" by the Court below (Appendix I, p. v).

The progressive die operations, and the production of various items thereby, advanced greatly during the war years, with tremendous interchange of know-how among all of the small and large operators, looking toward reduction of metal required and increase in speed of production. Contractors and subcontractors from the most unrelated fields used their tool and die makers, during the war years, experienced in wholly unrelated fields, to produce necessary tools, keyed to such progressive punch-and-die operations, to manufacture the most complicated parts necessary for the war effort. This was accepted as the work of men skilled in the use of such automatic metal stamping machinery. "Expediters", just as busy bees, communicated from tool shop to tool shop, the skills and know-how developed under the pressure of necessity and emergency. But a minuscule amount of this knowledge was ever recorded. Few, if any, patents were sought as no one knew which part of a process or product was his total creation. And most, if not all, was for the Government, and patents were accepted as of little value except to the Government.

The Examiner in the Patent Office is shown by the record either not to be a man skilled in the art, or to be insufficiently aware of the art in which he supposedly was an expert. The affidavit submitted in support of the application for reissue (DA. 77b) shows the suit patentees informing that Examiner of a number of patents which the Examiner had not considered during the prosecution of the original application, and, supposedly, made the reissue necessary. That Examiner likewise was completely unaware of Jones, 2,133,145 (PA. 200a) or Lindsay, 2,031,377 (PA. 198a).

Did the Act of 1952 Give to the Court of Appeals the Right to Ignore Its Own Stated Rules as to "Commercial Success"?

The Court of Appeals makes it important, as a basis for finding the patent valid, that "Plaintiff had established an almost complete monopoly of the 'two-piece clips in the market.'" The patentees obviously were not the first to make a two-piece clip. There is no evidence, there is no finding by the District Court, that merely because the suit patentees may have designed a structure which can be made more cheaply—and there was no proof acceptable to the District Court on this factor—that this was the reason for the commercial success of the patented item. The record does establish that the suit patentees had acquired great training and "know-how" in the field of automatic machinery for stamping parts (DA. 56b-57b). The application date of July 24, 1946 of the original application shows that the development by the suit patent took place when the end of World War II made it possible to make use of steel, forbidden during the war years. For the years from 1939 to 1945, substitutes such as aluminum were used. Aluminum, not a resilient metal, requires a separate spring. Leonardo I. Leon, whose patent No. 2,467,487, filed April 6, 1944 (PA. 186a), used

by Defendant, was taken as an example by Plaintiff-patentee, used aluminum. Machinery which had been used extensively during the war years for war goods now was turned to producing other than "war goods," even hair curl clamps. Many such patented processes and products, representing much greater savings in metal than here, were held not invention. *Talon, Inc.* v. *Union Slide Fastener, Inc.* (C. A. 9 Cir.), 266 F. 2d 731. It is taken for granted that the existence of these circumstances at the end of World War II are within the judicial knowledge of the Court.

During the war years, the civilian had money, but no place to spend it. Beauty parlors flourished. Women, whose dress and adornment have always been a great factor in the economy, began doing many things themselves. "Home permanents" were well advertised, so womenfolk turned to "doing their own hair." Any device useful for that purpose became more and more marketable. This situation was not the creation of Plaintiffs, the suit patentees, or the suit patent. Whatever growth took place was as easily understandable as in the case of *Paramount Corp.* v. *Tri-Ergon Corp.*, 294 U. S. 464, 474. There is no evidence in the record of any long felt want. The District Court found no long felt want. The Court of Appeals points to no evidence to support its statement of a long felt want.

The Court of Appeals confesses its own ignorance. Does the Act of 1952 require the Court to abdicate, and not make its own determinations, or voice its own opinions on this question of invention, on the development of the art which shows that there is no invention in an assembly of elements, in favor of some person or persons, nebulous, undefined, who supposedly are familiar with the subject? Is it not the function of a Court judicially to apply the rules laid down by this Court, in finding that the normal growth of an industry, par-

ticularly the growth and development of the mechanical arts, of automatic machinery, during the war years, was not invention merely because of surging demands from hungers unsatisfied during the war years, and then suddenly capable of being fed when the necessary metals became available? There is not a scintilla of evidence that the suit patentees created the demand by their alleged invention. There is no evidence that the sales of such mundane devices as bobby pins fell off. Indeed, Plaintiff-patentee himself, who presented a chart, the sole evidence of commercial success, did not have the books and records, and the District Court showed, by his remarks, how little credence he gave to this evidence (PA. 158a). There is no evidence as to bobby pins; yet this device was "billed" as a substitute for bobby pins. Indeed, Counsel for Plaintiffs admitted before the Court of Appeals, in argument, that the suit patent structure had not driven these other different devices off the markets. Have Plaintiffs thereby laid a proper foundation for the right to exact tribute not only for the past, but for every two-piece clip for hair clamping which will be placed on the market until January 18, 1966?

This Court, in *Paramount Corp.* v. *Tri-Ergon Corp.*, 294 U. S. 464, 474, 475, pointed out that where the evidence failed to show any general recognized demand for the invention involved until *after* the application for patent there involved was applied for, there was no evidence of long felt want to which the Court of Appeals alluded.

The record here is even more deficient. Every one in the United States knows how the restraints imposed during the war years prevented use of any development because of restrictions on critical metals. Was the avalanche of demand for flashy cars, stupendous refrigerators, classy washing machines and out-of-this-world television sets a reason for an exclusive monopoly for the first of any of these to get on the market after restrictions were lifted?

Where is the reason why Plaintiffs acquired "almost complete monopoly" should judicially be enlarged to an absolute monopoly, so that no one may purchase even the completely different two-piece clip of Defendant's accused structure without paying tribute to Plaintiffs (Appendix XI, p. LV)?

Certainly there had been greater scientific advances made in the *Paramount* and the *Altoona* Cases. Talking motion pictures were advanced from visual and manual synchronization of an ordinary rotating phonographic disc record with a vibrating film to a single unitary film fed through the same machine so that synchronization was automatic. The patent there was held invalid.

Judge Stewart, in his opinion, in *Cold Metal Products Co.* v. *Newport Steel Corp.* (C. A., 6 Cir., 1955), 226 F. 2d 19, 21, 22, *after* the Act of 1952 was in effect, admitted that the patents before him involved "a great practical advance over the art", and then proceeded to enumerate five outstanding, substantial advantages and advances. There also was great commercial success. But the patents which had taught so much, which represented these advances, were held to represent "nothing more than a felicitous selection of known elements", and no new result was found from the combination.

Here, the Court of Appeals found some element of difference between the side flanges of Jones and spurs and sockets in the suit patent the position of which is not even specified in the claim. And for this was there a mandate from Congress to forget about all of the logical rules of patent interpretation over the years, and to grant to Plaintiffs an absolute monopoly for seventeen years in any two-piece clip, because of some saving of material not mentioned, not claimed, not specified within the objects or the claims or the specifications of the suit patent?

This same Court of Appeals, indeed the same Judge, had announced a rule in *Foxboro Co.* v. *Taylor Instru-*

ment Companies (C. C. A., 2 Cir., 1946), 157 F. 2d 226, 233-234, which is here completely ignored:

> "Only in case we have some assurance that the success was here due to those factors by which the claims differed from the prior art, ought we take it as a criterion; and it would certainly be a gratuitous assumption to suppose that the industry's acceptance of these machines was due in any measure to those factors in the claims, if indeed there were any."

That same Judge, in this case, refuses to point out wherein the alleged novel features are specified in claim 3, or wherein there is any evidence that any such novel feature, even if it had been defined in the claim, has been the moving factor in producing the commercial success which has been made the major premise relied upon by the Court of Appeals in finding validity. That same Judge does not attempt to justify his position now vis-a-vis his earlier position.

Such a complete departure from all of the rules of patent construction laid down by this Court and by the Statutes, it is respectfully submitted, was not the mandate of Congress if Congress had indeed made any mandate. To make it clear to the Courts that the Act of 1952 did not transfer the claim formulating authority to the Courts, it is respectfully submitted this Petition for Certiorari should be granted. When the bases for the decision by the Court of Appeals are neither supported by the record, nor in the opinion itself, it is submitted that the Act of 1952 did not arm the lower court with any new authority completely to disregard the necessity for finding evidence in the record to support statements of the Court, and for finding within the four corners of the Letters Patent the facts upon which to support that patent, and within the four corners of any claim the elements upon which the

Court relies to find the structure which it asserts is distinctive over the prior art for patentability which structure must be found to have been the reason for the alleged commercial success. There is no statute nor decisional law which provides a court with the right to engraft upon a claim not only that which does not appear in the claim itself, but even within the patent specification itself.

The reasoning by the majority opinion of the Court of Appeals seems to consider an important basis the dissenting opinion of Mr. Justice Jackson which had been rejected by this Court in 1945. No, says the writing Judge. He says the Act of 1952 is a mandate not to go back to 1945, but back to some indefinite doctrine in *Hotchkiss* v. *Greenwood*, 52 U. S. (11 How.) 248, 266, at the December Term 1850 of this Court. Does that mean that all of the rules of patent law, set down in well considered opinions which were as stable as the rules of real estate, are now abrogated, and that the Courts must now enter upon a new millenium of rule making and interpretation? Does it mean that the stability of patent interpretation has been thrown to the winds by an interpretation of the Act of 1952 which itself says nothing upon which one may base any such premise? From whence will come stability for the rules of interpretation if, in the Second Circuit, there is this newly diffused fog as to what rule to apply, while in so many of the other circuits any such conclusion is rejected as a *non sequitur?*

How far back is the Act of 1952 supposed to abrogate the rules of patent law? To 1850? Then why not all the way back to the original interpretatipns of patentability? Are we, in the era of high speed, electronically controlled machinery, to think of invention in terms of the skilled artisan who made shoes by hand, spun wool on the spinning wheel, and used iron hoops for tires instead of tubeless rubber tires?

A reading of the opinion of the Court of Appeals gives the distinct impression that it is a challenge to the Supreme Court to say, nay, to its pronouncements. The bench in the case of *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530, made the authority for the decision in the instant case, included the writing Judge here and Judge Swan. In that case, the patent had been held valid below. The Court of Appeals unanimously affirmed.

In the present case, the patent had been held invalid below. A strange thing happened on the argument before the Court of Appeals. Reference is made to the Petition for Rehearing (Appendix II, p. ix) as to some of the extraordinary happenings. One thing not mentioned in that Petition takes on peculiar impact here.

The bench, sitting at the opening of Court that day, was made up of Judges Swan and Medina, both senior Judges, and Judge Clark, an active Judge. The case which was last on the calendar was heard first, so the instant case became the last case. As the case before the instant case concluded, the bench rose with an announcement of a short recess. After an interval, Judge Learned Hand appeared, took over the presiding position, and Judge Clark retired. Thus the bench now was composed only of senior Judges.

When the Petition for Rehearing was filed, the Attorney for Petitioner included a specific request for a rehearing *en banc* under a rule so recently promulgated it could not be found in the reporting services. The Attorney for Petitioner personally delivered copies of that petition to the chambers of each of the active Judges. Judge Clark, who has denied that the *Bausch & Lomb* Case has been made the law of the Second Circuit, and who had been displaced on the argument date by Judge Learned Hand only for the instant patent case, voted that the Petition for Rehearing be heard *en banc* (Appendix IV, p. xxx).

The Attorney for Petitioner has been informed that identically the same procedure, of displacing Judge Clark by Judge Learned Hand from the bench consisting of Judges Swan, Clark and Medina, had been followed three days earlier in the case of *Frances P. Norman, et al.* v. *Leonard Lawrence*, argued November 1, 1960, where the patent likewise was held valid, there affirming a holding of validity out of the same Court. But Judge Swan, who had been of the bench in the *Bausch & Lomb* Case, refused to follow Judge Learned Hand either in *Norman* v. *Lawrence*, just referred to, or in the instant case. He dissented in both cases, and voted to reverse and hold the patent *invalid* in the *Norman* Case, and to affirm Judge Byers, and hold the patent *invalid* in the present case, thus obviously taking the position that, regardless of any philosophy such as debated in the *Bausch & Lomb* Case, there was no sound reason to hold either of these insupportable patents valid.

These facts are set forth here because they appear to point to a positive intent to make it necessary for this Court to take this entire matter under advisement. At least in the *Bausch & Lomb* Case, there was some measure of scientific advance in the field of optics. In the case here, as Judge Byers had pointed out, the art presented a melange of spurs, sockets, openings, ears, trunnions, clamp plates, integral springs, springs going over pivot points, dihedral angles, two-piece clips, in many and varied combinations. He found the suit patent was merely an aggregation. And indeed it is. For if there is anything new in the spur and socket arrangement (and Jones (PA. 200a) and Woodfull (PA. 182a, D. Ex. H-13) positively say, no), what has that to do with the specific spring structure?

But apparently, according to the Court of Appeals, the Act of 1952 must also have abrogated the doctrine of aggregation and old combination, which had been stated, in 1936, in *Bassick Mfg. Co.* v. *Hollingshead Co.*, 298 U. S.

415, 425, which had been approved in *Lincoln Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545, 549-550. For apparently all that the suit patent had done was to make spurs and openings, different from Jones. No reliance is placed by the Court upon any new cooperation, any new result, flowing from this association, except the metal saving because the spurs and sockets are different from the flanges of Jones.

This saving of metal has already been shown here to be an afterthought, as found in *Lincoln Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545, 550, since, as there, the alleged saving of metal is not even hinted at either in the specification or throughout the argument before the Patent Office (D. Exs. F and G). In the case just mentioned, reference is made to *James* v. *Campbell* (1881), 104 U. S. 356, 370, 371, which points to the forceful words of Mr. Justice Grier, in *Burr* v. *Duryee*, 1 Wall. 531, that reissue patents should not be allowed when the originally issued patent was neither inoperative nor invalid, a matter for consideration by the Court of Appeals here because the facts upon which the reissue application here was based were known to Plaintiffs *before* the original patent issued.

However, *James* v. *Campbell* is important here for its plain statement (104 U. S. 370) that the court should not be called upon to explore the history of an art "in order to ascertain what a patentee *might have included* in his patent had he been so disposed." Since the whole matter of metal saving is without any assertion either in specification or claim, or even argument before the Patent Office both in the original application or in the reissue, the Court of Appeals should not be permitted to abrogate, by means of some indefinite interpretation of the Act of 1952, all rules as to sufficiency of statement in specification and claims, to "write" for Plaintiffs a claim they themselves had never sought from the Patent Office. "But, clearly, a patentee cannot claim the benefit of an

element of his invention thus vaguely and indefinitely hinted at." *Western Electric Co.* v. *Ansonia Co.*, 114 U. S. 447, 452; *Grant* v. *Walker*, 148 U. S. 547, 554.

Furthermore, certainly it cannot be that the Court of Appeals has a right to rewrite claim 3 to grant Plaintiffs a monopoly of every possible method of saving metal in the manufacture of hair clips. For certainly, in principle, in structure, Defendant's accused structure is a complete departure from the teaching of the suit patent. If anything, the accused structure rejects the principle of requiring the spring to press the spurs into the openings to keep the plates from separating, and uses its projections and barbs positively to form a permanent, *inseparable* hinge in the manner of the ears and trunnions of the prior art, or the interlocked tongues of Lindsay.

When the Court of Appeals holds the accused structure to infringe despite this prior art, it is not only using the Act of 1952 to abrogate the doctrines of recent rulings by this Court, and not only abrogating an ancient doctrine such as *Atlantic Works* v. *Brady* (1882), 107 U. S. 192, but is going to the full extent of abrogating, on the question of infringement, such outstanding authorities as *Burr* v. *Duryee* (1863), 68 U. S. (1 Wall.) 531, and *Westinghouse* v. *Boyden Power Brake Co.* (1897), 170 U. S. 537, to grant to Plaintiffs a monopoly for something they had indeed rejected by the testimony during the trial when they argued that their spurs and sockets were different from ears and trunnions because the trunnions had to extend *laterally*, not vertically, to engage an opening to form a bearing. They had to admit that while ears and trunnions positively held the parts against separation, whether the spring were there or not,—and that this was true also in the accused structure,—spurs and sockets in and of themselves would not hold the plates against separation.

Did Congress, by the Act of 1952, Mandate That the Courts Shall Not Determine Whether Alleged Inventions or Discoveries Are Within the Constitutional Provision as to the Issuance of Patents?

The Court of Appeals overrules the decision by the District Court, and, using the words of Mr. Justice Douglas, in the *Great A. & P. Case* (1950), 340 U. S. 147, almost expressly "overrules" the rule there announced by Mr. Justice Douglas. That decision was not just a passing fancy of this Court. It most probably is the most cited case since it was handed down. The extent of its application is shown in *Crest Specialty* v. *Trager*, 341 U. S. 912, where this Court, by a simple *per curiam* decision, reversed the Court of Appeals' reversal of the District Court's opinion, with but a simple reference to the *Great A. & P.* Case.

Thus, in the words of Mr. Justice Douglas, the Court of Appeals is granting to Plaintiffs here "the privilege of exacting tolls from the public" based upon a monopoly ill defined in the claim, in the Court of Appeals' decision, an alleged invention which certainly has not been shown: "to serve the ends of science—to push back the frontiers of chemistry, physics, and the like; to make a distinctive contribution to scientific knowledge." The claim here is indeed a gadget. The differences here are the "shadow of a shade of an idea" condemned in *Atlantic Works* v. *Brady*, 107 U. S. 192, 200.

It was old to hinge two plates together by means of a dihedral angle of one plate resting upon the surface of the other plate. It was old to press those members together by means of a spring. It was old to hold those plates from moving laterally or forwardly with relation to each other by means of projections from one plate engaging recesses in the other plate, and right at the pivot point, and within the bounds of the edges of the plate. It was old to make these projections and recesses integral with

the plates. It was old to cut a spring from one plate, extend it over the hinge point and there press it against the other plate, to hold them together. Moreover, it was old, as in the accused structure, to have a spring which reached through holes in the handle, and over the pivot at the engagement of the dihedral angle, to engage against the plate and force the plates to close one against the other.

Did the spurs and sockets in the suit patent work any better because the spring was cut from metal of one plate? Obviously, it did not. Did it make any difference in the operation of the spurs and sockets whether they were spurs and sockets, or whether they were ears and trunnions? Obviously not. There was one difference. Where the ears and trunnions were used, the plates remained assembled regardless of the presence or absence of the spring. This the prior art taught. This, the accused structure utilized. But in the suit patent, unless its spring held the parts together, the plates would fly apart.

How does the fact that the spurs and sockets are inboard from the edge of the plates, even if it had been specified and claimed, affect the function of the spring? Does it make any difference whether the spurs and sockets are in the same position as the side flanges in the Jones patent, or are inboard from the edge, to make the spring function properly? The Plaintiff-patentee did not think so.

Judge Learned Hand discusses in *extenso* the manner in which the spring is formed from the plate. But there is nothing of this in claim 3. So far as claim 3 is concerned, the spring can have its root anywhere in the plates, or extend in either direction, so long as it extends across the pivot point and presses against the other plate to press the plates together. The spring does not have to extend, according to the claim, from a handle, across the pivot point, to press against the plate.

Must the Court, as Mr. Justice Douglas said, determine whether there has been an advance in science and the arts which merits the grant of a patent? Or is Judge Learned Hand right, that without any direction from Congress, the Courts may not inquire as to whether an alleged invention has advanced the arts within the direction of the Constitution? Is it new law that a patent claim does not have to recite the elements necessary to produce the alleged new result?

For infringement, this Court has said repeatedly, there must be a taking not merely of some structure which a semantic sequence of words describes. There must be an appropriation not merely of the principle of the invention, but also of the elements of the machine, or their full equivalents. Judge Learned Hand does not expressly say that this rule has been abrogated, but his decision here goes directly in the face of that principle laid down in *Burr* v. *Duryee*, 68 U. S. (1 Wall.) 531, 570, as cited in *Westinghouse* v. *Boyden Power Brake Co.*, 170 U. S. 537, 556, that much less can any inference be drawn from the statute that

> "* * * * an inventor who has made an improvement in a machine, and thus effects the desired result in a better or cheaper manner than before can include all previous inventions and have a claim to the whole art, discovery or machine which he has improved. *All others have an equal right to make improved machines*, provided they do not embody the same, or substantially the same devices, or combinations of devices, which constitute the *peculiar* characteristics of the previous invention.'" (Emphasis added.)

Further herein it will be considered that Judge Learned Hand makes his decision without a finding by the District Court as to a better and cheaper manner of production

which fails completely of any disclosure in the patent specifications. For this he has included in the almost complete monopoly which Plaintiffs already have, in the language of the decision, "all previous inventions", so that Plaintiffs may have "claim to the whole art * * *" which (the suit patent is alleged to have) improved." To argue that the structure from which the suit patent has to distinguish (Jones and Lindsay) may thus be equivalent for the structure of the suit patent is, in the terms of the decision, "a flagrant abuse of the term 'equivalent'."

Will This Court Permit the Court of Appeals, Without Remand to the District Court, to Make Findings to Support a Reversal of the District Court, Where the District Court Not Only Failed to Find, But Refused to Sign, Such Findings When Submitted?

The District Court heard the witnesses. The record shows the District Court paid strict attention to the testimony, asking sharply pertinent questions as that testimony was presented. Yet, when the District Court made its decision, it made no finding at all on the matters of commercial success, of long felt want, of saving of metal. The District Court found in favor of Defendant. It must be presumed therefore, that the District Court refused to give any weight to that testimony, would not find commercial success, would not find that the patent was in terms of new result for saving of metal since the Court recognized that there was nothing in the patent as to any method of manufacture (PA. 165a). Apparently, therefore, the Court of Appeals, without remanding the case for new findings, without considering the requirement of Rule 52 F. R. C. P., that "* * * due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses", and where Plaintiffs make no showing that they ever requested any such findings and made no issue of the failure of the District

Court to make any such findings, and where the Court of Appeals has not held the District Court to be in error in failing to make any such findings, has no justification for its independent findings of commercial success, long felt want, and savings of metal. There is nothing to show that the District Court was clearly erroneous in his failure to find. Indeed, the record is so *de minimis* on these facets that there can be no "definite and firm conviction that a mistake has been committed", to overrule the District Court's findings. *United States* v. *Oregon Med. Soc.*, 343 U. S. 326, 339. There is no exception apparent why, on the appeal, what amounts virtually to a trial *de novo* should have been held. *United States* v. *Yellow Cab Co.*, 338 U. S. 338, 341-342. Indeed, it has been held that a Court of Appeals is "forbidden by statute, custom and rule from making new findings of fact, even where we believe these are demanded by the record." *Waialua Agricultural Co.* v. *Maneja* (C. A., 9 Cir., 1954), 216 F. 2d 466, 474. When trials *de novo* in courts of appeal were abolished, the appellate courts no longer had the right to make findings of fact, even when there was a written stipulation. *Randall Foundation* v. *Riddell* (C. A., 9 Cir., 1957), 244 F. 2d 803, 805. The Court of Appeals is without power to find facts. *Gotham Silk Hosiery Co.* v. *Artcraft Silk Hos. Mills* (C. C. A., 3 Cir., 1945), 147 F. 2d 209, 222. The failure of the trial court to find a fact essential to the defendant's recovery cannot be supplied by the appellate court, even if it thought the evidence in the record warranted it. *Hubshman* v. *Louis Keer Shoe Co.* (C. C. A., 7 Cir., 1942), 129 F. 2d 137, 142. See also *Johnson* v. *United States* (C. A., 5 Cir., 1958), 256 F. 2d 849, 850.

The District Court heard the evidence on these various factors, commercial success, long felt want, and the saving of metal. The District Court found for Defendant. Is it not to be presumed that the District Court rejected

this evidence which obviously had no support either in specification or claim, as having nothing to do with the question of invention? It has been held, in such case, that the appellate court must assume, in support of the judgment, that the trial court considered the evidence insufficient to sustain such a finding. *Sonken-Galamba Corp.* v. *Atchison, T. & S. F. Ry. Co.* (C. C. A., 8 Cir., 1942), 124 F. 2d 952, 958, certiorari denied 315 U. S. 822. The evidence must be viewed in a light most favorable to the prevailing party. *Judd* v. *Wasie* (C. A., 8 Cir., 1954), 211 F. 2d 826, 831. In this case, this would require that the Court of Appeals accept the trial court's failure to find to mean that he refused to give weight to any testimony as to commercial success, or saving of metal, and found no evidence of long felt want. This Court has heretofore reversed a decision of the same Court of Appeals which had set aside a jury verdict, and substituted its own conclusions. *Ferguson* v. *Moore-McCormack Lines* (1957), 352 U. S. 521.

That this position of Defendant is correct is shown by the situation which arose since the mandate of the Court of Appeals went down. As pointed out before, the District Court refused to sign a proposed Final Judgment (Appendix VI, p. xxxiv) and proposed Findings of Fact and Conclusions of Law (Appendix VII, p. xxxvi) which would have made the District Court mouth, as findings, what the Court of Appeals set up as findings to support its reversal. It is submitted that here again is sound basis why this reversal of the District Court by a divided court is unsound and unjudicial, and should merit the granting of the Petition here, regardless of the philosophy as to any mandate allegedly hidden in the enactment of the Act of 1952.

The District Court heard the expert witness and the Plaintiff-patentee in person. The District Court heard the witnesses for Defendant. The District Court was not impressed by the testimony of Plaintiffs' witnesses. On

what basis then may the Court of Appeals make findings which the District Court did not make? Certainly here the Court of Appeals is substituting its ignorance of the witnesses whose testimony obviously has been rejected by the trial court.

Conclusion

It is respectfully submitted that it appears necessary, in view of the positions here established, that the evident intent of the Court of Appeals for the Second Circuit to assure a determination upon the effect of the Act of 1952, that this Court grant the Petition for a Writ of Certiorari herein, to determine, among other things, whether, as stated by the majority opinion in the case here, the Act of 1952 mandates a new, so-called relaxed standard of invention in the consideration of Letters Patent. Important considerations ancillary to the main proposition are (a) whether "commercial success" has now become the dominant criterion of patentability, (b) whether it no longer is necessary to determine whether, in a combination of old elements, there has been effected a new result which has advanced the arts and science, (c) whether the so-called "relaxation" has eliminated the necessity for finding, in the patent claim itself, the elements relied upon as establishing invention, (d) whether the alleged "relaxed standard" is a sound basis for converting an almost exclusive monopoly into an argument for validity, despite the narrowness of interpretation required by the prior art, (e) whether, under this relaxed standard, the relation of the alleged infringement to the prior art no longer is a matter for consideration on the matter of infringement, (f) whether the Act of 1952 may be extended so far as to permit the Court of Appeals to make findings of fact without support in the record where the District Court either failed to find or refused to find such facts, and finally (g) whether the evident confusion of interpreta-

tion of the effect of the Act of 1952 by the various Circuits should not now be clearly resolved with a holding that there is no mandate from Congress abrogating the rules laid down by this Court up to the enactment of that Statute to require any new interpretations on the questions of validity and infringement.

Very respectfully submitted,

HENRY L. BURKITT,
Attorney for Petitioner,
Defendant-Appellee,
Office and Post Office Address,
19 West 44th Street,
New York 36, N. Y.
Murray Hill 2-7498

APPENDIX I

COPY OF DECISION OF COURT OF APPEALS FOR THE SECOND CIRCUIT

(489)

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 77—October Term, 1960.

(Argued November 4, 1960 Decided December 21, 1960.)

Docket No. 25662

KENNETH REINER and FRANK A. KLAUS, JR., d/b/a KAYNAR COMPANY and KAYNAR MFG. CO., INC.,

Appellants,

—v.—

THE I. LEON CO., INC.,

Appellee.

Before:

HAND, SWAN and MEDINA,

Circuit Judges.

Appendix I

On appeal from a judgment of the United States District Court for the Eastern District of New York, Byers, *J.*, presiding, dismissing the plaintiffs' complaint for the infringement of claims 1, 2, 3, 4, 7, 10 and 11, of Patent, Reissue No. 23,163.

WALTER P. HUNTLEY, *for the appellants.*
HENRY L. BURKITT, *for the appellee.*

---

(490) HAND, *Circuit Judge:*

This is an appeal from a judgment of Judge Byers, holding invalid for lack of invention claims 1, 2, 3, 4, 7, 10 and 11 of Reissue Patent No. 23,163. We are told that only claims 2 and 3 are in suit. The invention is for "clamps," used to maintain "formed curls" in a woman's hair, and the first question is whether the disclosure was an "invention." The "clamp" consists of two superimposed members, or "jaws," which open and close at one end under spring pressure, between which, when open, the curl is inserted, and which hold it fast when they are closed. It is difficult to give an adequate understanding of the device without the diagrams that are part of the disclosure, but perhaps the following verbal description may serve. Each member of the "clamp" is struck out of a piece of flat metal, and has two parallel prongs, joined together at one end to form a handle. The metal separating the prongs of the upper member is not cut away at the base where it joins the handle and remains attached as a part of the upper member, forming an intermediate tongue. This tongue is first bent upwards and then downwards between the prongs of the upper member.

Appendix I

It has a hook at its end which engages the edge of a slot in the lower member between the two prongs of that member.

The handle end of the upper member is bent upwards at a substantial angle, and the handle end of the lower member is slightly bent up, so that the handle ends of the two members are at a substantial angle to each other. When a user of the "clamp" presses together the handle ends, the prongs are forced apart against the resulting distortion of the tongue of the upper member, and the curl is inserted; and when this pressure is relieved, the prongs close again, grasping the curl.

Were this all, there would be nothing to keep the members from shifting laterally on each other, although they would (491) rock and the prongs would open and close on a fulcrum along the line where the plates are in contact. To remedy this defect the members are held together as follows. Near the handle end of the lower member two "spurs" are struck up out of the metal, and pass into corresponding "sockets" or holes in the upper member, large enough to receive the "spurs" with a loose accommodation. This coaction of sockets and "spurs" makes the two members functionally one, the members being held together by the engagement of the hook at the end of the tongue of the upper member to the lower member. Since the tongue spans the fulcrum of the "clamp," nothing more is necessary; the members will rock upon each other on the line of the "spurs" and sockets as long as the hook at the end of the tongue engages the slot between the prongs of the lower member.

The original application was filed on July 24, 1946 and a patent was issued on January 18, 1949. An applica-

tion for reissue was filed on July 12, 1949, on which the reissued patent in suit was granted on November 1, 1949. Before the date of the original application a number of patents for hair curlers had issued, and it is against the background of these that we must appraise the invention in suit. The first of them was Goodman's patent, No. 1,893,281, issued on January 3, 1933, one object of which was stated to be "to provide a light, strong and durable spring clip which is constructed without a hinge or pivot pin, and which may be readily manufactured on a high production basis at a relatively low cost" (p. 1, lines 8-12). It disclosed a "clamp," or a "clip," without pivot or hinge. This was followed on February 13, 1934, by a patent to Widerman, No. 1,946,561, which was "hinged." In 1936 a patent was issued to Lindsay, No. 2,031,377, for making a "hair curler," one object of which was making a curl which could be "replaced by an article of less size thereby promoting the drying of the hair" (p. 1, lines 25, 26). In 1938 a patent was issued to (492) Jones, No. 2,133,145 (which is incidentally the closest of all the prior art to the patent in suit), and whose purpose was that "the formed curls will be held in curled condition while the hair is moist" (p. 1, lines 4, 5). On February 28, 1939, a patent was issued to Fuscaldo, No. 2,149,214, one object of which was to provide "a new and improved pin or clip that may be removed without becoming entangled in the hair or the net worn by the user" (p. 1, lines 12-15). On July 14, 1942, a patent was issued to Boxer, No. 2,289,749, "for holding relatively flat curled curls or ringlets of hair during drying or 'setting' after which the device is to be removed" (p. 1, lines 2-4). On August 1, 1944, Leon filed an application for a design patent for a curl clip.

Thus, between the appearance of Goodman and application for the original patent in suit an interval had elapsed of thirteen years, the art had disclosed seven "clamps" for hair curlers; and the answer to the need for such a device had obviously been the subject of much experiment. How far any of these succeeded the record does not show; but it is apparent that the patent in suit has been widely accepted. Reiner, one of the inventors, had been in a war industry, and had had no experience in women's dress or adornment. Braga, his associate, was, so far as appears, equally unfamiliar with the subject matter. The record does not specifically show what attracted them to this kind of device; but it at once achieved an unexpected success. In the first year—1946—its sales approximated $40,000, which at ten cents for every three clamps meant a sale of over a million clamps, and in twelve years the sales had reached 90 million. In 1957 they were about 750,000 a day, and by 1958 the plaintiff had established an almost complete monopoly of the "two-piece clips in the market." These figures apparently the defendant does not challenge.

We are of course acutely aware of the constant reminders in the books that the sale of a patented device is not alone (493) a measure of its invention, and we accept that conclusion. Nevertheless, great commercial success, when properly scrutinized, may be a telling circumstance. It is idle to say that combinations of old elements cannot be inventions; substantially every invention is for such a "combination": that is to say, it consists of former elements in a new assemblage. All the constituents may be old, if their new concourse would not "have been obvious at the time the invention was made to a person having ordinary skill in the art" (§103, Title 35). That has been the statutory definition since January 1, 1953.

Appendix I

We discussed the question at length in *Lyon* v. *Bausch & Lomb Optical Co.*, 224 Fed. (2) 530, and have little to add to what we then said. There can be no doubt that the Act of 1952 meant to change the slow but steady drift of judicial decision that had been hostile to patents which made it possible for Mr. Justice Jackson in dissent to speak of the "strong passion in this Court for striking them" (patents) "down so that the only patent that is valid is one which this Court has not been able to get its hands on." (*Jungerson* v. *Ostly & Barton Co.*, 335 U. S. 560, 572.) That was in 1945, while the test laid down in *Hotchkiss* v. *Greenwood*, 11 How. 248, 266 still had a nominal authority, of which little remained in actual application. We still cannot escape the conclusion—as we could not when *Lyon* v. *Bausch & Lomb*, *supra*, was decided in 1955—that Congress deliberately meant to restor the old definition, and to raise it from a judicial gloss to a statutory command. It is not for us to decide what "discoveries" shall "promote the progress of science and the useful arts" sufficiently to grant any "exclusive right" of inventors (U. S. Constitution, Article 1, §2). Nor may we approach the interpretation of §103 of the Title 35 with a predetermined bias.

The test laid down is indeed misty enough. It directs us to surmise what was the range of ingenuity of a person "having ordinary skill" in an "art" with which we are totally (494) unfamiliar; and we do not see how such a standard can be applied at all except by recourse to the earlier work in the art, and to the general history of the means available at the time. To judge on our own that this or that new assemblage of old factors was, or was not, "obvious" is to substitute our ignorance for the acquaintance with the subject of those who were familiar

with it. There are indeed some signposts: e.g. how long did the need exist; how many tried to find the way; how long did the surrounding and accessory arts disclose the means; how immediately was the invention recognized as an answer by those who used the new variant? In the case at bar the answers to these questions all favor the conclusion that it demanded more intuition than was possessed by the "ordinary" workers in the field. The needs were known, but the purpose to fulfil them with that minimum of material and labor disclosed in the patent had not appeared; and economy of production is as valid a basis for invention as foresight in the disclosure of new means. In the case at bar the saving of material as compared to anything that had preceded, was very great indeed; the existing devices at once yielded to Reiner's disclosure; his was an answer to the "long-felt want."

Jones's patent, 2,133,145, is the nearest of all those offered, but the lower member, 11, is kept in register with the upper member, 10, by means of the "side flanges, 17," which requires the upper member to be different from the lower, and the use of more metal than the spur and socket device of the patent in suit. Moreover, the closing spring is altogether different. In such small and fragile devices slight divergences may be determinative. The "clamps" are small and easily lost; they must not be too troublesome to adjust, yet tenacious when in place. They are used in substantial quantity and cheap enough to make trivial their detachment and loss, which will be frequent. Nevertheless they are obviously an important accoutrement of a woman's wardrobe, as appears not only from the amazing quantities (495) sold, but from the repeated variants that kept coming upon the market. Unless we are to measure invention by the size and com-

plexity of the product, this new article fulfilled the qualifications for a patent. We hold Claim three valid.

The other defenses do not require any extended discussion. It is plain that the reissued Claim three did not enlarge the scope of the invention. It is also plain that its language reads, not only on the specifications, but upon the defendant's "clamp." The distinction suggested that the "resilient integral extension," i.e. the spring, pulls instead of pushes, the members together as in the defendant's "clamp" is irrelevant. Claim three does not contain as an element either method, and covers both. If there is a patentable distinction between the two, it might confine the patentees to the disclosure of their patent; but that would not invalidate Claim three. A claim must of course read upon the specifications, but the specifications, unless so declared, are only an example of what the claim is intended to cover; it is a species of a broader genus, else no claims would cover anything not literally described in the specifications. There is nothing in *Grubman Engineering & Manufacturing Co.* v. *Goldberger*, 47 Fed. (2) 151 (C. A. 2) to the contrary.

The judgment dismissing the complaint is reversed; judgment for the plaintiff will be entered on Claim three of the patent, and the complaint will be dismissed as to the other claims as moot.

SWAN, *Circuit Judge* (dissenting in part):

In my opinion Judge Byers' decision holding invalid claim 3 should be affirmed. I agree to dismissal of the complaint as to the other claims as moot.

APPENDIX II

PETITION FOR REHEARING OF DECISION OF COURT OF APPEALS FOR THE SECOND CIRCUIT

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 77—OCTOBER TERM, 1960

Docket No. 25662

[SAME TITLE]

PETITION FOR REHEARING

To the Honorable Justices of the United States Court of Appeals for the Second Circuit:

The I. Leon Co., Inc., Defendant-Appellee above named, presents this, its Petition for Rehearing of the decision of this Court in the above-entitled cause, dated December 21, 1960, reversing the decision of the Hon. Mortimer W. Byers, Chief Judge, United States District Court for the Eastern District of New York, and, in support thereof, respectfully shows:

Petitioner reserves its argued positions as to each of the points heretofore made for affirmance of the decision of the District Court, but, in this Petition, addresses itself solely to those features of the decision wherein it believes that the Court may be convinced its result is based upon the application of incorrect legal principles and the fail-

ure to take into account the facts established in the record before this Court. Therefore this Petition is devoted to convincing this Court that it has erred in its determination of the following questions and for the following reasons.

In view of certain dispositions by the decision, which, it is submitted, run directly contrary to the repeated decisions of this Court, Petitioner prays that this Petition for Rehearing may be reheard *en banc*, for a determination by the active judges of this Court, in accordance with Rule 25(b) of the Rules of this Court, effective April 25, 1960, and it is, therefore, respectfully prayed that copies of this Petition may be distributed to each of the active judges of this Court for consideration, in accordance with Rule 25(b), by each of such active judges so that one or more of such active judges may be in a position to reach the necessary opinion that this case should be determined by the active judges *en banc*:

I

Counsel for Petitioner, prior to the opening of argument in this case, had requested forty-five minutes in which to argue on behalf of Defendant-Appellee. Appellants, as Counsel for Petitioner is informed, also had requested forty-five minutes to present the argument on behalf of Plaintiffs-Appellants. Counsel for Appellants commenced his argument at 12:00 Noon on November 4, 1960. After 1:05 P.M., according to the watch of Counsel for Petitioner, it was indicated to Counsel for Appellants that he had overrun his time. He was permitted to conclude the phase of his argument in which he was then engaged with the result that Counsel for Petitioner could

not commence his argument until about 1:10 P.M. Thus, Counsel for Appellants had taken one hour and about ten minutes, instead of the forty-five minutes which he had requested, and had encroached upon the time which, from the calendar setting, had been allotted for argument by Counsel for Petitioner on behalf of Defendant-Appellee.

Thus there was remaining until the usual adjournment time of the Court about twenty minutes. Counsel for Petitioner had to reorganize his presentation in view of possible adjournment at 1:30 P.M. Counsel for Petitioner at once pointed out a number of misstatements by Counsel for Appellants which were directly contrary to the facts of the record, and then Counsel for Petitioner tried to proceed as quickly as possible with the argument as he had planned it. At about 1:30 P.M., the Hon. Harold R. Medina addressed Counsel for Petitioner to the effect that the bench had sat through a tiring day, and that the shots Counsel for Petitioner was firing would not have their proper effect under these circumstances, and that the case in any event would require a lot of homework, as Judge Medina put it. Counsel for Petitioner was constrained to bow to the indicated desires of Judge Medina since the time had already passed 1:30 P.M., and thus to terminate argument on behalf of Defendant-Appellee. It is felt that if Counsel for Petitioner had had a full opportunity to be heard, we would have been able to demonstrate to the Court the fallacy of the points upon which the decision herein now rests, and that the decision of the Hon. Thomas W. Swan, who voted for dismissal of the Complaint, would have been made the decision of this Court.

Appendix II

II

A basic error in the decision of the majority lies in its adoption of the rule of commercial success as the important criterion for determining patentability. That rule has been rejected repeatedly both in the Supreme Court of the United States and by the active judges of this Court. Judge Learned Hand himself has held that the evidence as to commercial success must follow certain rules. The rule he laid down in *Foxboro Co.* v. *Taylor Instrument Cos.* (C. C. A., 2 Cir.), 157 F. 2d 226, 233-234, has not been applied in the instant case. There Judge Hand said that:

> "Only in case we have some assurance that the success was here due to those factors by which the claims differ from the prior art, ought we take it as a criterion; and it would certainly be a gratuitous assumption to suppose that the industry's acceptance of these machines was due in any measure to those factors in the claims, if indeed there were any."

There is not the slightest evidence in this case that the success of Plaintiffs' clip had anything to do with the factors which the decision of the majority has written into claim 3 in order to sustain that claim against Jones, 2,133,145 (p. 200a; also see Montage at the end of Defendant-Appellee's brief) and the rest of the prior art, previously considered in full by Judge Byers. Plaintiffs-Appellants came into this business at the end of World War II. They were experts in the field of metal stamping by their experience in the use of that machinery in making "war goods". That was a time of the rise of various

businesses, particularly the luxury businesses devoted to the dressing and ornamentation of women.

The burden of establishing patentability is upon the Plaintiffs-Appellants, the proponents of the patent. Evidence as to alleged commercial success, which showed only increase of their sales after they entered the business of manufacturing and selling hair clips at a time when it should be a matter of judicial notice that every one was straining to buy, and to buy anything, when all business was enjoying an astounding growth—why should there be a burden upon Defendant-Appellee to prove the negative, that the growth of Plaintiffs' business rested upon these factors known to any one who has lived in this era since the end of World War II, that all luxury business grew at an astounding pace when purchasers, with purchasing capacity built up over the war years, and after restrictions were lifted, were out to buy anything and everything upon which they could lay their hands?

The majority refers to the fact that Plaintiffs-Appellants supposedly have a substantial monopoly in the hair clip business. Is this a reason for making the monopoly absolute? It would seem that the contrary should be true, that the claims of Plaintiffs-Appellants should be the subject of the strictest scrutiny under such circumstances.

Judge Moore, in *Deering, Milliken & Co.* v. *Temp-Resisto Corp.* (C. A., 2 Cir.), 274 F. 2d 626, 632-633, appears to have epitomized the position taken by the active judges of this Court. There Judge Moore recognized that, in that case, there had been extended unsuccessful research throughout the industry before making of the structure of the patent there in suit. Where is there any

such proof in the case here as to any research at all? As to any such lack of success? Judge Moore pointed out very clearly the position of this Court that, in the present day, every new article which appears on the market derives its commercial success from good advertising which makes the public conscious of a "long felt want" for the first time, that to attribute invention to any such factor is, as he says, to do an injustice, not to the inventive faculty, but to the art of salesmanship.

In the majority opinion here, the Court has cited the dissenting opinion of Mr. Justice Jackson, in *Jungerson* v. *Ostby & Barton*, 335 U. S. 560. That dissenting opinion, and the dissenting opinion in the Court of Appeals here to which Judge Jackson refers, are not the law binding upon this Court. The law is the majority opinion in the *Jungerson* case, 335 U. S. 560, and the majority opinion of this Court which was affirmed by the Supreme Court in that case. That position, both in the majority of this Court and the majority of the Supreme Court, is directly contrary to the position of the majority in this case.

The position of this Court on the case here is that two senior judges of this Court have voted to reverse not upon the law laid down by the majority opinion of the Supreme Court and the majority opinion of this Court, but upon the dissents which had been rejected in both cases. Judge Moore, on the other hand, in the *Deering. Milliken* case, 274 F. 2d 626, correctly relied upon the majority opinion of the *Jungerson* case, 335 U. S. 560, as well as the decisions in *Dow Chemical Co.* v. *Halliburton Oil Well Cementing Co.*, 324 U. S. 320, 330, *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 279, and *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U. S. 350, 356-357, as well as other decisions of this

Court. Certainly the cases considered by Judge Moore represent more striking examples of improvements over their respective prior arts, but yet the active judges of this Court struck them down as representing no invention. Thus, the law of this Court, as established by these recent cases, is the law which should be binding for a determination in the case here.

In the case here, the panel of judges consisted of three senior judges. One of those senior judges dissented, and voted to affirm Judge Byers. The majority cites as authority the dissenting opinion of a judge of the Supreme Court who has favored the dissenting opinion of the judge writing the decision in this case. Since that dissenting opinion had twice been overruled, it is submitted that this situation presents a proper case for this Court to exercise the newly defined authority for a rehearing *en banc* of the active judges of this Court.

Judges Swan and Byers agreed that the Complaint in this case should be dismissed. Judge Hand and Medina, for the reasons presented in the rejected opinions in the *Jungerson* case, voted to reverse Judge Byers. It is submitted that a situation such as this was the purpose for which the amendment of the rules as to rehearings was adopted. For this reason, Petitioner seeks relief by praying that this Petition for Rehearing may be heard by the entire bench of the active judges. A case such as this, which involves the application by a majority of a panel of doctrines of dissenting opinions which have been rejected both by the Supreme Court and by this Court should not be the subject of the vagaries of the selection of a panel to which Judge Clark once referred.

Appendix II

III

Another point which must be made against the majority opinion is the fact that the trial judge, not the judges in the Court of Appeals, heard the witnesses in their testimony as to the scope of the commercial success. His conclusions should be binding upon this Court, under Rule 52 F. R. C. P. on this subject, unless there is sound positive reasons why his conclusions should be upset. It is his province to believe or not to believe the witness who appears before him. When he finds against the Plaintiffs-Appellants, his finding, as in any case of a finder of the facts, must stand as having rejected the testimony of those witnesses for the losing side unless there is reason to believe that he should have believed the witnesses. What record evidence is there to prove commercial success? That Reiner, who admits that he did not know the figures, says that he believes that they have so much and so much business? Or that the advertising piece says that they have so much and so much business? Was Judge Byers not justified in believing that this was just so much puffing, and that he had no right to be carried away by such evidence without something more substantial? What other proof is there? And where does any burden arise against either Judge Byers or Defendant-Appellee to counter evidence of this nature?

The majority seems to want to place a burden upon the Defendant-Appellee to refute this "commercial success" of Plaintiffs-Appellants. But there was no evidence. There were no records. Indeed, Counsel for Plaintiffs-Appellants admitted, at the argument, that the other clips had not been driven off the market, despite the statement in the decision which seems to hold to that effect. Indeed, Reiner himself, one of the inventors, admitted in his testimony that he had the Colanite clip, Defendant-Appellee's clip,

before him when he was designing the clip of the suit patent. That is not mentioned in the majority's opinion. Reiner admitted that he had other clips before him when he was making that design structure. That is not stated in the majority opinion. This is not a case where a man skilled in the art of metal stamping machinery was operating in a complete vacuum. This is the application of the knowledge which this skilled man applied to an ordinary stamping problem.

IV

Another basic error in the decision of the majority lies in the premises which the majority set up to reach the conclusion. The majority takes the patent to Jones, 2,133,145, as the best reference. It finds that this best reference does not anticipate because (a) Jones has a flange at the edge to retain the pieces from moving laterally with relation to each other, and (b) the pushing spring of Jones is different from the pulling spring of the suit patent. Then the Court proceeds to find the accused structure to infringe, even though the majority admits that there were differences, one of which it finds in the difference in the springs. The majority, however, fails to consider that the pushing spring of the accused structure, with the arrangement of the spring extending through a hole in the handle of one of the blades of the accused structure, is the pushing spring of Jones, a structure which is in the public domain, being structure of an expired patent.

In this manner, the majority here not merely is holding that the suit patent claim is valid, but it is proceeding to extend to the suit patentees a monopoly for that which the

suit patentees did not design, did not disclose. Even by the testimony of Plaintiffs-Appellants' expert, the suit patentees could not have contemplated the accused structure because the method of passing a spring through a hole in a handle, which the accused structure uses, which Jones uses, was not a development of the suit patentees. The method of holding the plates to hinge them, in the accused structure, following such patents as Cahn (P. 190a) and others, was not a development of the suit patentees and was never contemplated by the suit patentees. Thus the majority is not merely holding that the suit patentees had designed something specifically to which they were entitled to a patent. The majority is holding that the suit patentees have made a material advance in a theory of operation, in a new method of manufacture, for which the majority then goes along to grant the suit patentees a monopoly so extensive as to preclude any one in the future, until the expiration of this patent, from making a two-piece clip. Yet, throughout the testimony, the expert for Plaintiffs-Appellants hedged away from making any such claim. And well he might in view of the prior art patents, and the generally recognized principle otherwise, that to make in one piece what previously had been made in two or more pieces, would not, without more, be invention. Thus, the majority is giving the Plaintiffs-Appellants the right to exact tribute from the public not merely for the clip of the suit patent, but for any clip which is manufactured according to well known progressive die operations in the making of a two-piece clip, methods of operation so common during and after World War II.

Certainly it is not within the province of this Court to grant to Plaintiffs-Appellants a monopoly for that which,

under the patent laws, has become open for use by all. Thus the attempt to withdraw from the public domain the use of a croupier's rake, to be used upon a counter, with sidewalls and other features, was condemned in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, in very sharp language. Great commercial success was evidenced there. Nothing of that nature had been done for the years that supermarkets were in operation. As necessity increased with demand, a design appeared which took the old elements and assembled them into what was a completely novel relationship, as the Court there found. But the commercial success, the Court held, was not enough to raise that novel relationship to the level of invention. What additionally is there present here to show invention?

V

The majority has failed to consider that the means for holding the pieces against lateral movement, in the accused structure, is something which neither the suit patent nor Jones nor any one else has ever shown. This was admitted by the expert for Plaintiffs-Appellants. Also the majority ignores the fact that the means for holding the pieces against sidewise movement, in the accused structure, holds the pieces against any separation, not only sidewise movement. The Court fails to consider that the accused structure does not follow the suit patent in this direction, but follows the prior art, where the barbs function just as the trunnions and ears in the prior art (see Cahn, Exhibit GGG, attached to Defendant-Appellee's Brief). The suit patentees did their best to differentiate from such structures as Cahn, while trying to hold on to

a claim for a structure where the so-called spur means extended directly upwardly, as it does in Jones. The barbs of the accused structure (see Schildt patent No. 2,687,737, Exhibit YY, opposite D. 95b) function exactly the same way, extended in exactly the same manner, as the trunnions and ears of the prior art. These barbs in the accused structure are the necessary elements to keep the plates from flying apart, and, as in the prior art, function like the ears and trunnions to form a hinge. But the suit patent structure had to have a pulling spring with a hook to engage an edge of one plate to hold the pieces together. Thus, as the suit patent differs from the prior art, so does the suit patent differ from the accused structure.

After Defendant had taught Plaintiffs how to do it, Plaintiffs proceeded to change their spring from that upon which they had based their claim for patent. They changed their engagement of the spring from that which had been defined in the patent. They did not follow their own original teachings. They followed those of Jones just as Defendant-Appellee has followed Jones. Now, because the two structures do not look exactly alike, that is, the suit patent structure and the prior art trunnions and ears, Plaintiffs-Appellants argue that they have made an advance in the method of manufacture. But claim 3 has nothing whatsoever to do with any method of manufacture.

Perhaps the suit patent is valid. But it is only valid to the extent in which it differs from the prior art. And its difference from the prior art is not defined in claim 3, but in the specific structure disclosed, as to the pulling spring and the hook, none of which was taken by the accused structure.

Appendix II

VI

The majority overlooks the differences in the manner of construction of the accused structure, of the Jones patent, and of the suit patent structure. The spring of the suit patent structure is cut from the body and the handle of one plate, then is bent outwardly away from that plate, and then is bent toward the plates and passes through *both plates* to engage the *other plate*. That spring *never* passes through a hole in any *handle*. At its end, it hooks up an edge provided upon the other plate, and pulls upon that edge to pull the pieces together.

In Jones, the spring passes through a hole in one handle, and passes across the pivot, to engage against a face of the plate through which the holes provide for passage of the spring, and to press against that face. In the accused structure, the spring, cut from one plate, extends through a hole in the handle of the other plate, just as in Jones, and then, just as in Jones, passes over the pivot to engage against the face of the plate through which the openings were provided for the passage of the spring. The springs, in both Jones and in the accused structure, pushed against the plate faces against which their ends are engaged. If the accused structure is the equivalent of the suit patent structure, then Jones is the equivalent of the suit patent structure. Those premises inexorably lead to the conclusion that the suit patent structure is neither novel nor inventive in light of Jones. The premises in the majority opinion necessarily lead to the conclusion, that the accused structure, which is the Jones structure, spells out invalidity if it falls within the terms of claim 3.

Appendix II

VII

In the suit patent, the so-called spur means and socket means, of which the majority makes much, *cannot* retain the parts against separation. The majority admits that the hook, in the suit patent, is required to hold the pieces against separation (p. 491 of the decision). But in the accused structure, the pieces are held together by the barbs which also retain the pieces against lateral movement. The spring, in the accused structure, has no function for retaining the parts against separation.

Claim 3, indeed the specification of the suit patent, does not require that the "spur means" and the "socket means" be at any definite position with relation to the side edges of the plates. Indeed, the inventor himself made it clear that he considered his invention to extend to any construction even if the spurs and openings were at the very side edges of the plates. Reiner, in his own unmistakable language (D. 63b), said that "If they (the plates) have outwardly projecting lugs, they fall within the patent if they engage another lug which has a recess in it which is disposed vertically". Yet, if the outwardly projecting lug is included, that includes structure which does not have the economy of metal to which the majority refers as the basis for its decision.

The majority makes much of the alleged difference between the suit patent and Jones because Jones has a slight barrier at the edges. Is there anything in the suit patent which says the spurs are of any specific size? Obviously not. Is there anything in the suit patent which explains why the spurs and sockets must be inboard from the edges of the plate? Obviously, not. The inventor himself testified that it was not so required.

Indeed, if there were anything in producing projections spaced from the side edges of the plate, then the majority should have considered the Australian patent to Woodfull, 118,458 (Exhibit D-H 13, P. 182a). Could it be clearer that there would be no invention in positioning the "spur means" and the "socket means" spaced from the side edges of the plate in view of the disclosure in this patent? Would it be possible to hold that it is invention to make as a stamping what is shown to have been old in the Woodfull patent? And just where is there the slightest intimation in claim 3 that the structure is to be made *as a stamping from sheet metal, to save metal?*

Then on what logical basis may the majority read into both claim and specification the contrary of that which the inventor himself has read into his alleged invention? There does not appear to be the slightest legal authority for any such revision of both claim and specification. It was to this type of interpretation that Mr. Justice Stone addressed himself, in *Altoona Theatres* v. *Tri-Ergon Corp.*, 294 U. S. 477. How can the claim be held to differentiate patentably from the slight projection at the edge of the plate which Jones calls a flange, where that flange is to engage against the edges of the immediately adjacent plate? And where is this different from the prongs which, Reiner says, are bent up to the other plate, would engage in an opening and an ear in the other plate, and be within his patent?

VIII

The majority apparently is laboring under a misapprehension as to the difference between the Jones patent and the suit patent. The majority says that Jones "re-

quires the upper member to be different from the lower" (decision, p. 494). Aside from the fact that claim 3 does not differentiate from this structure in any degree, the suit patent members 1 and 2 are completely different from each other, just as they are in Jones (Exhibit P-3, P. 174a).

IX

The majority has completely overlooked the fact that claim 3 does not specify a complete structure. The dihedral angle, much stressed at the trial, must be present if the clip is to work. The decision (p. 490) described a structure which requires the dihedral angle. The majority opinion makes coincidence of the location of the spur means and the vertex of the dihedral angle a specifically required ingredient of the patented structure (p. 491). Yet this likewise is completely absent from the claim. Yet this location of means for retention of the angularly disposed member against side movements was as old as the Australian patent to Woodfull, 118,458 (Exhibit D-H 13, P. 182a). The fact that Jones did not use Woodfull's method of preventing lateral movement did not present the suit patentees with the right to monopolize any means of this nature. Is the invention then in making as a stamping what obviously had been made by Woodfull in some other material? But the claim does not so define. Is it then the majority's position that the claim should be considered to be amended to define a stamping made of metal which has defined boundary edges, with the spur means and the socket means spaced inwardly from the edges of the plates? This is neither in accord with the statements of the inventor himself, nor with the claim

itself, nor with the specification. If the spur means of the suit patent are at the edge, they are the same as Jones. If the spur means are spaced from the edge, then they are the same as Woodfull. The majority opinion apparently attempts to rewrite claim 3 to include the Woodfull construction, and thus violates the rule, long established, which may be a platitude but still stands as a rule of law, that a court should not preempt the functions of the Patent Office and itself correct or rewrite claims as they should be done in reissue applications.

The Court has overlooked the very specific requirement that the sockets to cooperate with the spurs must be located at the vertex of the dihedral angle. The claim does not even mention the dihedral angle, or the location of the sockets at any such angle. This is the sort of thing to which Mr. Justice Stone referred to in the *Altoona* case. The vagueness of the claim may not be used for the purpose of rewriting that claim, in an opinion, to bring it into accord with the requirements of the Statutes. Plaintiffs-Appellants sought a reissue. When they failed to accomplish their purpose to correct the errors in the claims, those errors may not be alleviated in this manner to eliminate those defects.

The majority appears to be in error in deferring, being willing to substitute for what the majority calls "its own ignorance, "the acquaintance with the subject of those who were familiar with it." Just who those who are familiar "with it" are is not made clear. It is inconceivable that the majority is abdicating in favor of the Plaintiffs themselves. But if it is, sufficient has been said here, it is submitted, to make clear that the inventor himself has positively demonstrated that his claim is completely anticipated by Jones as well as other of the

prior art patents. If the majority is deferring to the Examiners, then, it is submitted, the position of the Examiners has been made clear by Mr. Bert Russell, the Senior Examiner, in his article, quoted in Defendant-Appellee's Brief, which shows that the Examiner has 'passed the buck,' as Mr. Russell puts it, to the Courts. Plaintiffs-Appellants have had a full opportunity to prove to this Court that they had made a great advance in the art. Insofar as Plaintiffs-Appellants' hook end and spring construction, is concerned, the Defendant-Appellee has raised no question as Defendant-Appellee's structure is completely different from the suit patent structure, and follows Jones and the other prior art patents.

X

Another factor which the majority fails to take into consideration in deferring to those unknown people who are supposed to be familiar with the subject, is that the patent to Jones, the patent to Lindsay, neither was considered by the Examiner. There is no presumption arising that the Examiner would have issued the claims over the Jones patent. Indeed, the record here shows that the Examiner, at the time of the application for reissue, had to have his attention called to prior art patents which he had not considered originally, and yet such patents were right in his own class. It is made clear in the record that the suit patentees had to modify their claims in view of this prior art which the Examiner had never considered up to the time of the reissue, and until the suit patentees brought those patents to the attention of the Examiner. Then how can there be any presumption in favor of such a claim issued by such an Examiner,

where neither the suit patentees nor the Examiner had ever considered that patent, and when the majority says that the Jones patent was the best reference?

XI

The majority apparently attempts to hold claim 3 valid not because of anything in claim 3, but because of some saving of metal for which there is not a single word in the specification or claim to support any such position. There is nothing in the specification of the suit patent,—and this was admitted by the expert for Plaintiffs-Appellants, and was admitted by the patentee himself,—that has anything to do with the method of manufacture. Thus, the foundation for invention which the majority lays down finds no support whatsoever within the four corners of the suit patent. Furthermore, Judge Byers heard the oral testimony of these witnesses. He found against Plaintiffs-Appellants. His findings must be considered to mean that he was not impressed and did not accept the statements by these witnesses. It is obvious from the portions of the record which Plaintiffs-Appellants have submitted that Judge Byers was intent upon the testimony on this matter of manufacture. His decision is a complete rejection of any acceptance on his part of that testimony.

XII

The majority opinion appears to have overlooked completely the new matter as to the method of manufacture which was introduced into the specification long after it was filed. The majority appears to have fallen into the trap which Plaintiffs-Appellants tried to set for Judge

Byers, but which he successfully avoided. He heard the testimony of the witnesses as to the alleged facts of the benefits in production. He also heard them admit specifically that there was not the slightest statement in the suit patent as to the method of manufacture except the part which the expert could not make work, and which had been introduced into the application long after it had been filed. This insertion of a description into a specification after it has been filed has been condemned in many cases, and reference is made to the condemnation by Mr. Justice Brandeis of just such proceedure, in *Permutit Co.* v. *Graver Corp.*, 284 U. S. 52, 58-60. This, the only part of the specification which had anything at all to do with the process of manufacture,—and this had only to do with the assembly of the two pieces after they had been made, and had nothing to do with the saving of metal,—that was "new matter", and was improperly included in the patent. Indeed, the patent should be held invalid for such an amendment.

Conclusion

Wherefore, upon the foregoing grounds, it is respectfully urged that this Petition for Rehearing may be heard *en banc*, and may be granted, and that the judgment of the District Court may be, upon further consideration, affirmed.

Very respectfully submitted,

Henry L. Burkitt,
Attorney for Petitioner,
Defendant-Appellee.

Dated: New York, New York,
January 5, 1961.

APPENDIX III

ORDER DENYING PETITION FOR REHEARING OF DECISION OF COURT OF APPEALS FOR THE SECOND CIRCUIT

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

[SAME TITLE]

BEFORE: HAND, SWAN and MEDINA, C.JJ.

On peti[illegible]or rehearing.

Henry L. [illegible]itt for appellee.

Petition for rehearing denied.

(sgd) LEARNED HAND
(sgd) HAROLD R. MEDINA
U. S. C. JJ.

January 9, 1961

APPENDIX IV

ORDER DENYING PETITION FOR REHEARING IN BANC BY COURT OF APPEALS FOR THE SECOND CIRCUIT

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

—o—

[SAME TITLE]

—o—

PETITION FOR REHEARING IN BANC

Henry L. Burkitt, New York N. Y.,
for petitioner, defendant-appellee.

All of the active judges concurring, except Judge Clark who votes to grant, the petition for rehearing in banc is denied.

J. EDWARD LUMBARD
J. Edward Lumbard
Chief Judge

January 18, 1961

APPENDIX V

PERTINENT PROVISIONS OF CONSTITUTION AND STATUTES

Constitution, Article I, Section 8: The Congress shall have the Power * * *

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries; * * *.

28 U. S. C. §1254. Courts of appeals; certiorari; appeal; certified questions

Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree; * * *. June 25, 1948, c. 646, 62 Stat. 928.

28 U. S. C. §1291. Final decisions of district courts

The courts of appeal shall have jurisdiction of appeals from all final decisions of the district courts of the United States, the United States District Court for the District of the Canal Zone, and the District Court of Guam, and the District Court of the Virgin Islands, except where a direct review may be had in the Supreme Court. As amended October 31, 1951, c. 655, §48, 65 Stat. 726; July 7, 1958, Pub. L. 85-508, §12(e), 72 Stat. 348.

28 U. S. C. §1292. Interlocutory decisions

(a) The courts of appeal shall have jurisdiction of appeals from: * * *

(4) Judgments in civil actions for patent infringement which are final except for accounting * * *. As amended Oct. 31, 1951, c. 655, §49, 65 Stat. 726; July 7, 1958, Pub. L. 85-508, §12(c), 72 Stat. 348; Sept. 2, 1958, Publ. L. 85-919, 72 Stat. 1770.

28 U. S. C. §1338. Patents, copyrights, trade-marks, and unfair competition

(a) The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, copyrights and trade-marks. Such jurisdiction shall be exclusive of the courts of the states in patent and copyright cases.

(b) The district courts shall have original jurisdiction of any civil action asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent or trade-mark laws. June 25, 1948, c. 646, 62 Stat. 931.

35 U. S. C. §102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

* * * * *

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, * * *. July 19, 1952, c. 950, §1, 66 Stat. 797.

35 U. S. C. §103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. July 19, 1952, c. 950, §1, 66 Stat. 798.

35 U. S. C. §112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

APPENDIX VI

FINAL JUDGMENT ON MANDATE PROPOSED BY PLAINTIFFS TO UNITED STATES DISTRICT COURT FOR EASTERN DISTRICT OF NEW YORK AND NOT SIGNED BY JUDGE BYERS, TRIAL JUDGE

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF NEW YORK

Civil Action No. 13,308

[SAME TITLE]

FINAL JUDGMENT

This cause having been tried before this Court and a Decree entered in favor of Defendant on the 8th day of April, 1959 from which Decree an appeal was duly taken to the Court of Appeals for the Second Circuit and from which an Order has been duly issued to this Court and filed herein on January 10, 1961, reversing the said Decree of this Court and ordering that judgment for the Plaintiffs be entered holding Claim 3 of United States Reissue Patent No. 23,163 valid and infringed and dismissing the Complaint as to the other claims as moot; therefore, it is

ORDERED, ADJUDGED AND DECREED:

1. Plaintiffs' Supplemental and Amended Complaint is sustained as to infringement of Claim 3 of United States Reissue Patent No. 23,163 and is dismissed as to claims 1, 2, 4, 7, 10 and 11 as moot.

2. Defendant's First and Second Counterclaims are dismissed.

Appendix VI

3. Defendant, its officers, agents, servants, employees, and attorneys, and those persons in active concert or participation with them who receive actual notice of the Order by personal service or otherwise shall be enjoined for the full term of United States Reissue Patent No. 23,163 from making, using, or selling clamps covered by Claim 3 of said patent or otherwise in any manner infringing said patent.

4. Plaintiff shall recover from Defendant general damages adequate to compensate Plaintiffs for the infringement herein adjudged but in no event less than a reasonable royalty for the use made of the invention by the Defendant, together with interest and costs on the Complaint and for dismissal of Defendant's Counterclaims, to be hereafter fixed by the Court or the Clerk thereof.

5. This cause is referred to a Special Master, ...
....., who is hereby appointed to take evidence on (1) the Plaintiffs' loss of profits, (2) the Defendant's profits, and (3) a reasonable royalty, and to ascertain and report to this Court the general damages which shall be due to the Plaintiffs; and the Defendant The I. Leon Co., Inc., its officers, agents, servants, and employees, and all those in concert with it, are hereby directed and required to attend before the Special Master as he may direct and to produce before him such information and documents as relate to the matters in issue and to submit to such oral examination as the Master may require.

Date: .....

.....
United States District Judge

APPENDIX VII

FINDINGS OF FACT AND CONCLUSIONS OF LAW PROPOSED BY PLAINTIFFS TO UNITED STATES DISTRICT COURT FOR EASTERN DISTRICT OF NEW YORK TO SUPPORT JUDGMENT ON MANDATE AND NOT APPROVED BY JUDGE BYERS, TRIAL JUDGE

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF NEW YORK

Civil Action No. 13,308

KENNETH REINER and FRANK A. KLAUS, JR., doing business as THE KAYNAR COMPANY, and KAYNAR MFG. CO., INC.,

Plaintiffs,

vs.

THE I. LEON CO., INC.,

Defendant.

FINDINGS OF FACT AND CONCLUSIONS OF LAW*

This cause having been tried before this Court and a Decree entered in favor of Defendant on the 8th day of April, 1959 from which Decree an appeal was duly taken and from which an Order has been duly issued to this Court and filed herein on January 10, 1961, reversing the said Decree of this Court and ordering that judgment for

* Notation by Judge Byers: "2-21-61 I see no occasion to make Findings in addition to those made by me heretofore. M. W. B. U. S. D. J."

the Plaintiffs be entered holding Claim 3 of United States Reissue Patent No. 23,163 valid and infringed and dismissing the Complaint as to the other claims as moot; therefore, the Court makes the following Findings of Fact and Conclusions of Law:

FINDINGS OF FACT

1. The Plaintiffs Kenneth Reiner and Frank A. Klaus, Jr. are citizens of the United States and residents of the County of Los Angeles, State of California, and comprise a partnership doing business as The Kaynar Company and having its principal place of business in the County of Los Angeles, State of California.

2. The Plaintiff Kaynar Mfg. Co., Inc. is a corporation organized and existing under and by virtue of the laws of the State of California and has its principal place of business in the County of Los Angeles, State of California.

3. The Defendant The I. Leon Co., Inc. is a corporation organized and existing under and by virtue of the laws of the State of New York and has a regular and established place of business within the Eastern Judicial District of New York.

4. Patent No. 2,459,452, entitled Clamp, was duly and legally issued to Kenneth Reiner and Armand Braga on January 18, 1949, and thereafter, on July 12, 1949, said patent was surrendered to the United States Patent Office, and a reissue thereof on the same invention was duly and legally issued as Reissue Patent No. 23,163, the patent in suit, on November 1, 1949, to the said Reiner and the said Braga.

Appendix VII

5. On July 15, 1946, by an instrument in writing recorded in the United States Patent Office in Liber B208, Page 290, all of the right, title and interest of Armand Braga in and to said Patent No. 2,459,452 and said Reissue Patent No. 23,163 was assigned to the said Kenneth Reiner, who thereafter held the entire right, title and interest in and to said patents in trust for the Plaintiff partnership, The Kaynar Company.

6. On May 21, 1957, by an instrument in writing recorded in the United States Patent Office on Reel 362, Frames 147 and 148, the entire right, title and interest in and to the said Reissue Patent No. 23,163 in suit was transferred to the corporate plaintiff, Kaynar Mfg. Co., Inc., which is the present owner thereof.

7. The subject matter of the patented invention relates to clamps or clips for use in particular for holding formed curls in women's hair.

8. The two-piece hair curl clips made in accordance with the patent in suit were first commercially produced in 1946 by the Plaintiff partnership and at once achieved an unexpected and great commercial success, which continued to grow so that in the next twelve years the sales of such clips reached 90 million, and by 1957 were being produced at the rate of about 750,000 per day.

9. The manufacture of the patented clip was accompanied by very great saving of material and the clamp of the patent was the answer to a long felt want.

10. Before July 24, 1946, the date of the original application for the patent in suit, a number of patents

for hair curlers or clamps had issued, among them the patent to Goodman, No. 1,893,281, issued January 3, 1933; to Widerman, No. 1,946,561, issued February 13, 1934; to Lindsay, No. 2,031,377, issued February 18, 1936; to Jones, No. 2,133,145, issued October 11, 1938; to Fuscaldo, No. 2,149,214, issued February 28, 1939; and to Boxer, No. 2,289,749, issued July 14, 1942.

11. The Jones patent No. 2,133,145 is the nearest of all those offered, but the lower member, 11, is kept in register with the upper member, 10, by means of the "side flanges, 17" which requires the upper member to be different from the lower and the use of more metal than the spur-and-socket device of the patent in suit. Moreover, the closing spring is altogether different.

12. Between the issuance of the first of these prior patents to Goodman and July 24, 1946, the date of the application for the original patent in suit, there was a need for clamps for hair curls on women's heads, and such a need was the subject of considerable experiment. The need was not satisfied by the devices of any of the prior patentees, but was satisfied by the device of the patent in suit which was immediately accepted.

13. The prior art patents do not anticipate or show lack of invention in the Reissue patent in suit No. 23,163, considered either singly or in combination.

14. Claim 3 of the Reissue patent in suit did not enlarge the scope of the invention over the original patent and properly claims the invention of said patent in suit.

Appendix VII

15. The Defendant has made and sold clamps within the Eastern District of New York and elsewhere which infringe Claim 3 of the patent in suit.

16. The language of Claim 3 of the patent in suit reads not only upon the specification of the patent, but also upon the Defendant's clamps.

17. Claim 3 of the patent in suit is not limited to the species illustrated in the specification of the patent in suit, but is intended to and does cover a broader genus.

18. The patent in suit is infringed by clamps manufactured and sold by the Defendant and which include the spring and spur-and-socket means defined in Claim 3 as exemplified by Plaintiffs' Exhibits 9, 10 and 11.

19. The Defendant had actual notice of its infringement of the patent in suit, but continued to wilfully and wantonly infringe said patent by making and selling and causing to be made and used and sold clamps embodying the invention covered by said patent.

20. The Plaintiffs have not been guilty of unclean hands and the Defendant has failed to support the allegations of its First Counterclaim.

21. The Plaintiffs have not violated any provisions of the Antitrust Laws of the United States, and the Defendant has failed to support the allegations of its Second Counterclaim.

Appendix VII

CONCLUSIONS OF LAW

A. This action arises under the Patent Laws of the United States and this Court has jurisdiction thereof under 28 U. S. C. 1338 (a).

B. Reissue Patent No. 23,163 was duly and legally issued on November 1, 1949 and is good and valid in law.

C. The Defendant has infringed Claim 3 of said patent in suit.

D. Plaintiffs' Amended and Supplemental Complaint is sustained with costs to Plaintiffs.

E. Plaintiffs' Amended and Supplemental Complaint for infringement of claims 1, 2, 4, 7, 10 and 11 of said patent in suit is dismissed as moot.

F. Defendant's First Counterclaim is dismissed with costs to Plaintiffs.

G. Defendant's Second Counterclaim is dismissed with costs to Plaintiffs.

H. The Plaintiffs are entitled to a judgment for a permanent injunction and an accounting with costs as prayed for in the Complaint on file herein.

Dated this ..... day of February, 1961.

.....
United States District Judge

APPENDIX VIII

FINAL JUDGMENT ON MANDATE AS PROPOSED BY DEFENDANT TO UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF NEW YORK, AND APPROVED BY JUDGE BYERS, TRIAL JUDGE

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF NEW YORK

Filed
In Clerk's Office
U. S. District Court, E. D. N. Y.
* Feb 23 1961 *
Time A. M.
P. M.

Civil Action No. 13,308

[SAME TITLE]

FINAL JUDGMENT

This cause having come on before this Court, and the Decree heretofore entered herein in favor of Defendant on the 8th day of April, 1959, having been reversed by the Court of Appeals for the Second Circuit, and that Order to that effect having been filed herein on January 10, 1961; it is

Appendix VIII

ORDERED, ADJUDGED AND DECREED:

1. That United States Reissue Letters Patent No. 23,163, issued on November 1, 1949, is good and valid as to claim 3 thereof;

2. That Defendant, The I. Leon Co., Inc., has infringed said claim 3 of said United States Reissue Letters Patent No. 23,163;

3. That the Supplemental and Amended Complaint herein be dismissed as to claims 1, 2, 4, 7, 10 and 11 of said United States Reissue Letters Patent No. 23,163, as moot;

4. That the First and Second Counterclaims of Defendant herein be dismissed;

5. That a perpetual injunction issue out of and under the seal of this Court, enjoining Defendant, The I. Leon Co., Inc., its officers, agents, servants, employees and attorneys, and those persons in active concert or participation with said Defendant, and who may receive actual notice of this injunction, be enjoined, for the full valid term of said United States Reissue Letters Patent No. 23,163 from making, using, or selling clamps coming within said claim 3 of said United States Reissue Letters Patent No. 23,163;

6. That Plaintiffs recover their costs and disbursements in this suit to be taxed;

7. That the case be referred to David Kane, Esq., 420 Lexington Ave. as Special Master, to ascertain the amount of the damages adequate to compensate Plaintiffs for

said infringement by Defendant, and to determine a reasonable royalty for the use made of the invention of said claim 3 of said United States Reissue Letters Patent No. 23,163 by Defendant, and to report to this Court for the determination by the Court of the amount to be awarded to Plaintiffs as damages by reason of said infringement; and that Plaintiffs, on the taking of the account before said Special Master, shall have the right to cause an examination of Defendant, The I. Leon Co., Inc., ore tenus, or otherwise, as the Special Master may determine, and also said Special Master shall have the right to cause the production of all proper books, vouchers and documents of either or both of the parties for the determination as to a reasonable royalty and to direct the attendance of either of the parties hereto before him for such purposes from time to time as said Special Master shall direct.

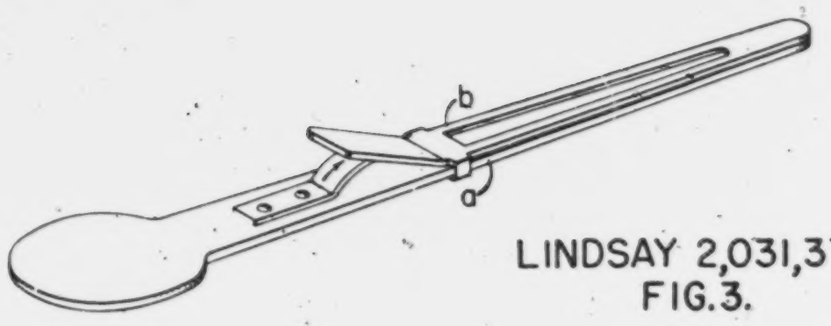
Dated: Brooklyn, New York,
February 21st, 1961.

MORTIMER W. BYERS
United States District Judge

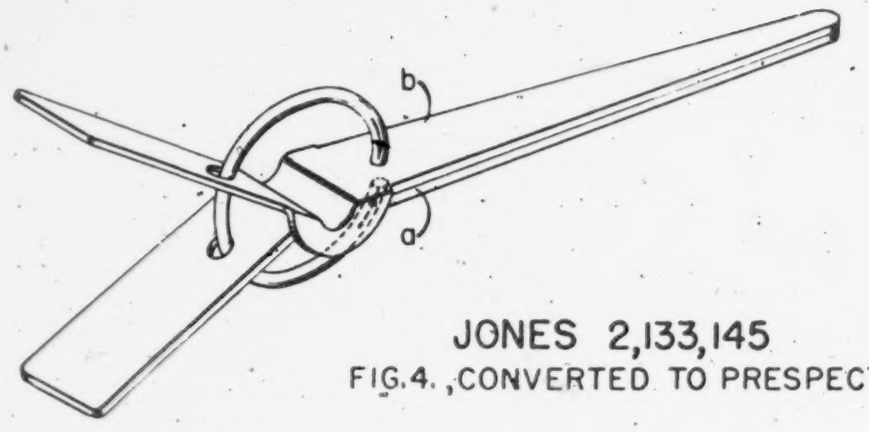
us Court for the
it to be awarded
l infringement;
account before
t to cause an
Inc., ore tenus,
determine, and
right to cause
ers and docu-
the determina-
ct the attend-
him for such
l Master shall

W. Byers
District Judge

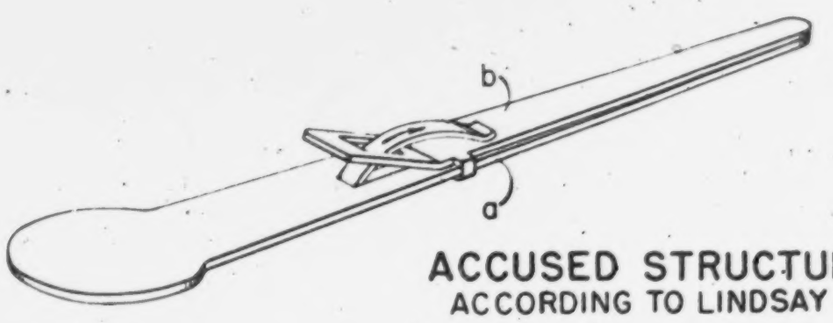
MONTAGE OF
PRIOR ART
ACCUSED STRUCTURE ACCORDING TO PRIOR ART
AND
SUIT PATENT STRUCTURE (MODIFIED)



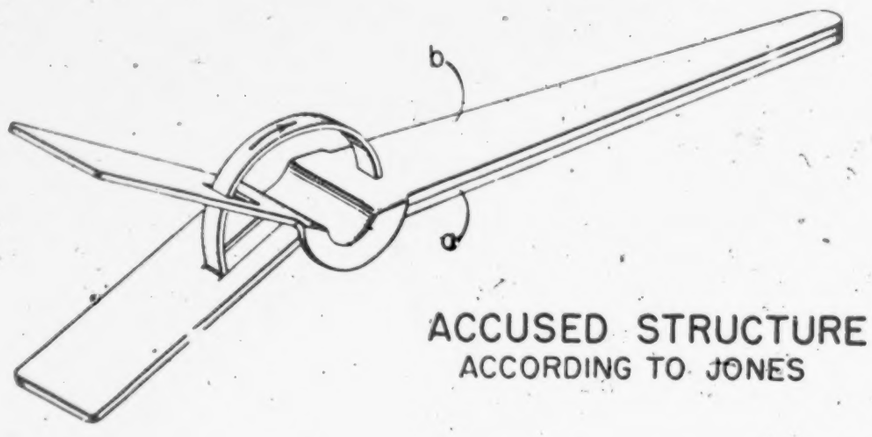
LINDSAY 2,031,377
FIG.3.



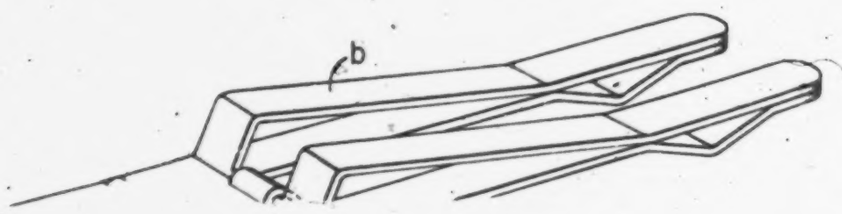
JONES 2,133,145
FIG.4., CONVERTED TO PRESPECTIVE



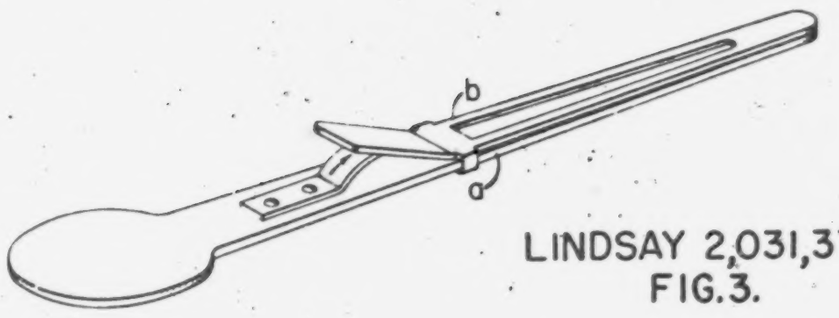
ACCUSED STRUCTURE
ACCORDING TO LINDSAY



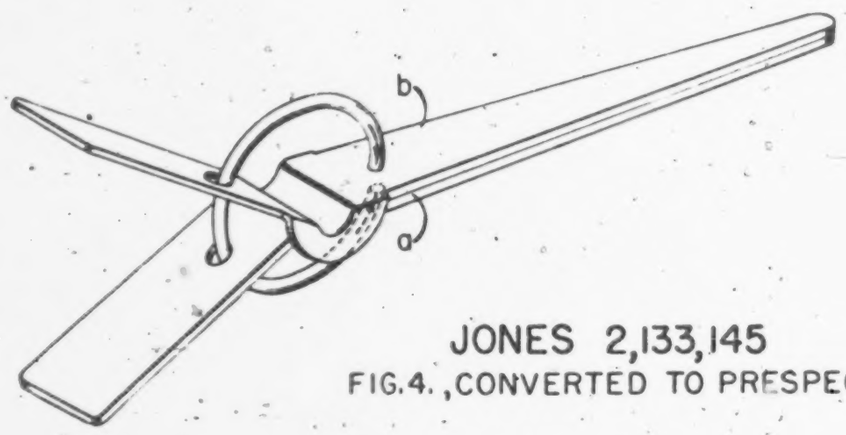
ACCUSED STRUCTURE
ACCORDING TO JONES



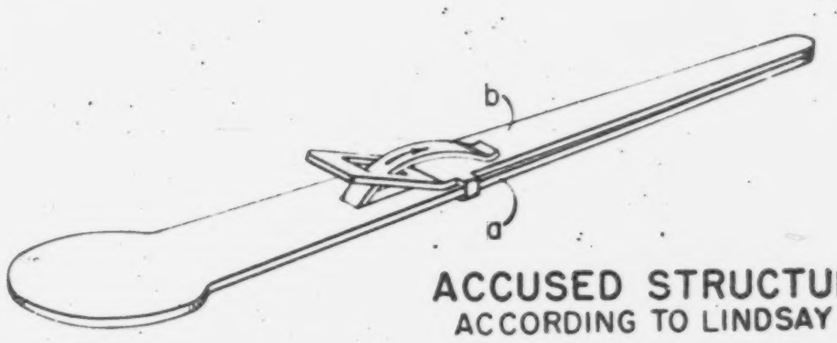
ACCUSED STRUCTURE ACCORDING TO PRIOR ART
AND
SUIT PATENT STRUCTURE (MODIFIED)



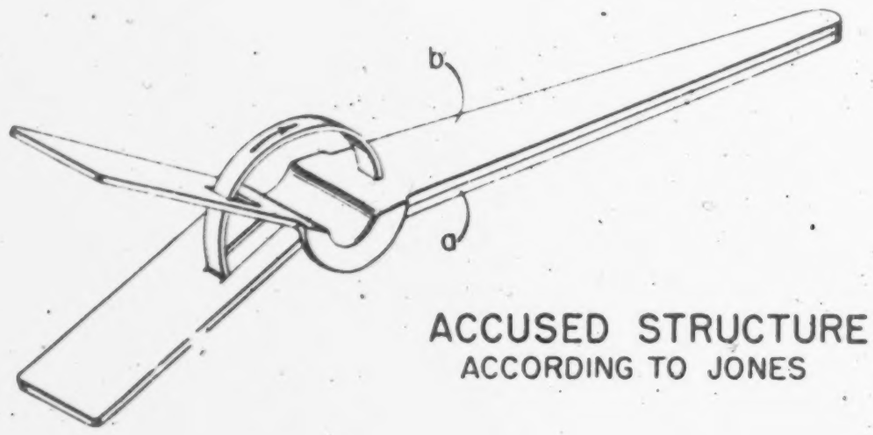
LINDSAY 2,031,377
FIG.3.



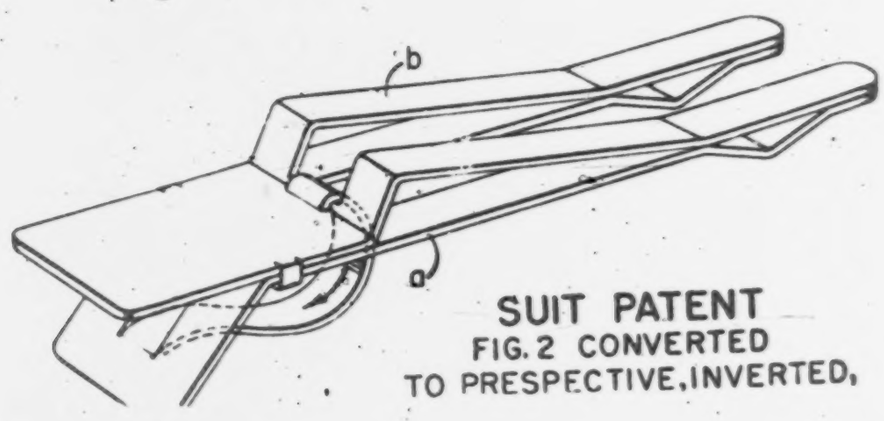
JONES 2,133,145
FIG.4., CONVERTED TO PRESPECTIVE



ACCUSED STRUCTURE
ACCORDING TO LINDSAY



ACCUSED STRUCTURE
ACCORDING TO JONES



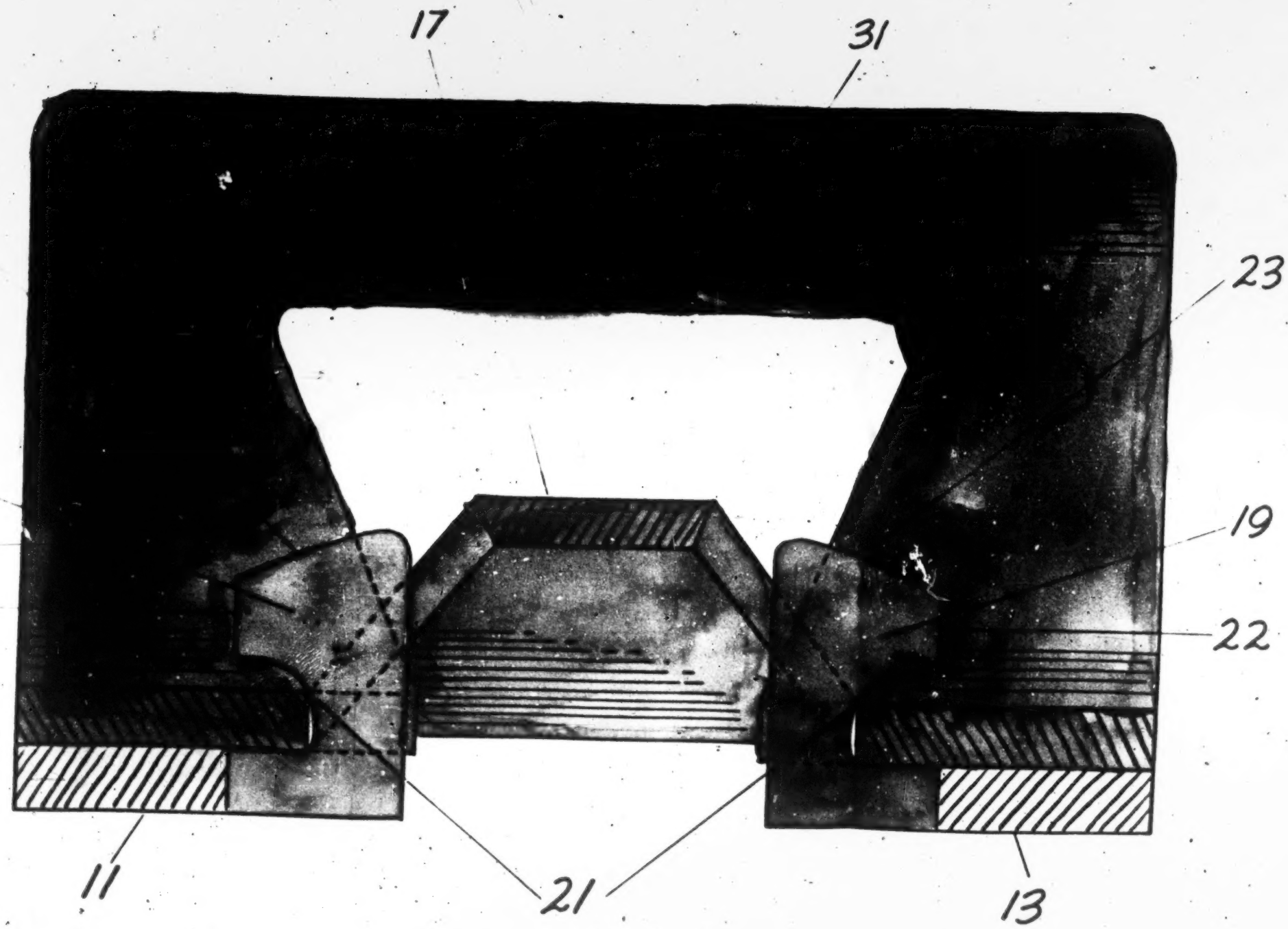
SUIT PATENT
FIG. 2 CONVERTED
TO PRESPECTIVE, INVERTED,

APPENDIX X

Reproduction of Defendant's Exhibit ZZ

[For the Convenience of Court and Counsel This Photo Is Bound in on the Opposite Page]

FIG. 5



APPENDIX XI

Further Excerpts From Testimony

• • • • •

(1405) Jesse Solomon, called as a witness on behalf of the defendant, having been first duly sworn, testified as follows:

Direct Examination by Mr. Morton:

Q. Mr. Solomon, with what concern are you connected? A. Solo Products Corporation.

Q. Where is their place of business? A. 279 Fifth Avenue, New York City.

Q. In what capacity are you associated with Solo Products Corporation? A. I am secretary and treasurer of the Solo Products Corporation.

• • • • •

(1406) Q. Now, I show you Defendant's Exhibit ZZZ in evi- (1407) dence, a memorandum, and ask you to kindly inspect it and state if you have ever seen it before (handing)? A. Yes, sir, I have.

Q. What is the date of that memorandum? A. April 19, 1949.

Q. How did that memorandum come to get in my possession? A. Well, we gave it to you, guess.

Q. Where did you obtain it when you gave it to me? A. From our files.

Q. How long had it been in your files? A. From the very moment that we received it. When we received this we were in litigation with the—I guess it is the plaintiff in this case, Kaynar.

Appendix XI

Q. With Kaynar Manufacturing Company? A. Yes, sir.

Q. You were in litigation with them here in Brooklyn, were you not? A. In litigation with them here in Brooklyn, and in Los Angeles, California.

* * * * *

(1409) Q. I show you Defendant's Exhibit K in evidence, and ask you if you can identify that (handing) curl clip as the curl clip that you were then offering to this particular customer? A. That is correct, this is the clip that we were offering at that time; it was known as No. 212 and 313.

* * * * *

(1417) Q. Did you subsequently institute an action in this court? A. Yes, sir, we instituted an action in the Federal Court? A. Yes, sir, we instituted an action in th Federal Court here in Brooklyn, the District Court, against Kaynar Manufacturing Company, Incorporated.

* * * * *

(1420) The Court: Did the case go to trial?

Mr. Free: The case terminated by dismissal with prejudice signed by the attorneys.

The Court: I didn't mean to anticipate.

I thought that it might be a convenient place in (1421) the record for you gentlemen to agree as to what happened in that case.

Mr. Free: It never went to trial.

The Court: Do you agree?

Mr. Morton: It never went to trial is true.

Appendix XI

The Court: How was the case disposed of as a matter of record?

Mr. Morton: It was——

Mr. Free: Dismissal with prejudice entered, signed by the Clerk, the date seems to be given.

The Court: Is that on consent?

Mr. Free: November 16, 1950.

The Court: November?

Mr. Free: November 16, 1950. It was filed in the Clerk's office.

* * * * *

(1430) Mr. Morton: * * * Now, after this action had been commenced, the Kaynar Manufacturing Company, the writer of the letters, brought an action in California for patent infringement upon the Reiner original patent No. 2459452, and obtained jurisdiction there over Solo Products Corporation because it was licensed to do (1431) business in California, and they joined, to make sure that they did get jurisdiction, they joined a customer of Solo Products Corporation with the result that Solo Products Corporation appeared in that action and defended the infringement suit.

* * * * *

(1435) Q. Who was your counsel? A. Well, we had four attorneys—we had Cooper, Keith, Byrnes & Dunham—it is a very long name. I may have left out one or two.

The Court: We know the Cooper firm. Were they the attorneys of record in either case?

Appendix XI

Mr. Morton: They were the attorneys of record in the case in this court.

The Court: In Brooklyn?

Mr. Morton: Yes, sir.

A. Weisman & Feyrer.

Q. They were all in New York City? A. All in New York.

In Los Angeles, we had Fulwider & Mattingly.

* * * * *

(1437) Q. Was there any discussion as to the cost of obtaining a final determination? A. Oh, yes, there very definitely was because we already had spent——

The Court: Yes, the answer is Yes. Don't make a speech.

The answer is yes.

The Witness: Okay.

* * * * *

(1438) Q. Following these conversations, what did your corporation decide to do? (1439) A. We decided to discontinue the action in Brooklyn and the defense of the action in Los Angeles owing to the tremendous cost involved.

* * * * *

Q. Did the cost enter into your decision not to continue with this litigation? A. The cost was the only consideration that entered into our decision.

* * * * *

(1447) Q. Please state what you recall, Mr. Solomon, that Mr. Reiner said to you at that time. A. The upshot of the conversation——

The Court: Don't tell us the upshot. What did Mr. Reiner say?

(1448) The Witness: Mr. Reiner said that they had a broad patent on a two-piece curl clip and they were not going to permit anybody to infringe or make a two-piece curl clip.

Q. Are you still making a curl clip as exemplified by Defendant's Exhibit K in evidence which you are holding in your hand? A. We are not making any two-piece curl clips.

Q. By the way, was that two-piece curl clip, Defendant's Exhibit K, patented by Solo Products Corporation? A. Oh, yes, sir, we had a patent issued on it.

Q. Do you recall the name of the inventor who applied for that patent? Do you recall the name of the inventor? A. Yes, sir, Nat Solomon.

Q. Who is he? A. My brother and president of Solo Products Corporation.

Q. I show you the copy of U. S. Letters Patent No. 2464739 granted March 15, 1949——

The Court: Is that in this file.

Mr. Morton: Yes, sir.

The Court: What is the number?

Mr. Morton: 2464739, upon the application filed February 10, 1948.

Appendix XI

(1449) Q. I ask you to just—the patent was applied for by Nathan L. Solomon and Anderson, assignors to Solo Products Corporation, a corporation in New Jersey.

Will you please examine the drawing of that patent and tell us if you can whether that is the patent you have referred to as having been obtained on Defendant's Exhibit K. A. Yes, sir, it is.

* * * * *

(1450) Q. Does Solo Products Corporation still own Patent No. 2464739? A. Is that the one in question on this product?

Q. Yes, on Defendant's Exhibit K. A. I believe we surrendered it to——

Q. To whom? A. To Kaynar.

Q. Was that part of the settlement that was made? A. Yes, sir, that was part of it.

The Court: By surrender do you mean assigned?

Q. You mean transferred it to them? A. I just don't know what it is. I have the agreement here, as to what we were supposed to do. If I may refer to it, I will see.

(1451) The Court: You said "we surrendered." And my only comment is that perhaps surrendered is not the correct word.

Mr. Morton: He means assigned.

The Witness: It might not be the correct word.

The Court: Assigned I think, is what you mean.

The Witness: Yes.

Appendix XI

Q. You mentioned an agreement, was there an agreement at the time this litigation was terminated? Was there an agreement made? A. Yes, sir, there was an agreement made.

Q. Do you have the original agreement in court? A. Yes, I do.

Q. Will you produce it?

Mr. Free: I object to the relevancy of this.

The Court: It hasn't been offered yet.

Mr. Morton: It is already in evidence on the question of admission—on the request of admissions they admit this agreement was made.

• • • • •

(1462) A. Well, we sold this item until restrictions on aluminum were instituted by the United States Government I believe in 1940—the spring of 1940.

Q. And then, because of the restrictions, what happened with respect to the sale of that item? A. We had to discontinue the use of all aluminum for this type of purpose and naturally we had to discontinue the product.

Q. That was for the duration of the war? A. Yes, sir.

Q. Can you recall with any reasonable degree of certainty when those restrictions were lifted? A. I believe they were restricted early in 1947.

The Court: You mean lifted?

The Witness: Lifted.

Q. They were lifted in 1947? A. In 1947; in so far as the use of aluminum was concerned.

• • • • •

Appendix XI

(1479) *Re-direct Examination by Mr. Morton:*

* * * * *

Q. And would it be fair to say that it is desirable from the standpoint of the Solo Products Corporation to be able to supply each trade that may demand it with a two-piece pin curl clip? A. Yes, sir. Very definitely. As a matter of fact, I would like to be able to make a two-piece steel clip.

Q. Well, why don't you make a two-piece steel clip? A. Because we are not permitted to by the agreement that we had signed and the assignment of our patent. We are (1480) not permitted to make a two-piece clip of steel.

Q. In other words, you can't even today make the two-piece clip that your brother invented. Is that correct? A. That is correct.

* * * * *

(1488) VICTOR LEON, recalled, having been previously sworn, further testified as follows:

Direct Examination by Mr. Morton:

* * * * *

(1496) The Court: I would like to ask perhaps this is not a proper question to ask this witness—I noticed just this morning in these Exhibits 9 and 10, that without very much effort a lateral play between the upper and lower clamping members occurs.

Is that the reason why there was a change, a subsequent change, in design?

Appendix XI

Mr. Morton: No, that is not the reason, your (1497) Honor. This witness——

The Court: Do you see what I mean?

Were you aware of that?

Mr. Morton: No, I was not aware of it, your Honor.

The Witness: Lateral?

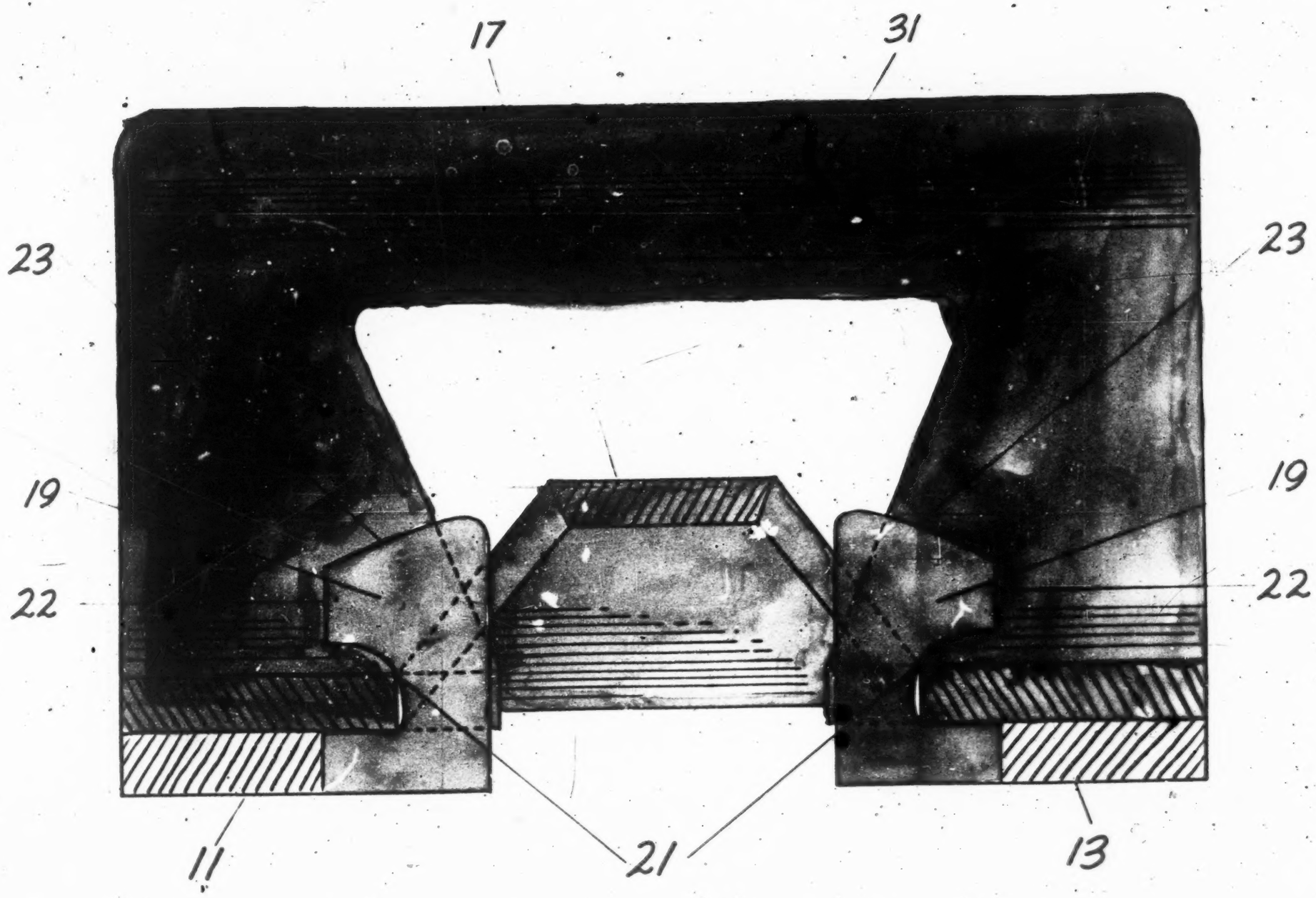
The Court: I don't know if it is true of Exhibit 11.

Exhibit 11 seems to be more firm in that respect I wondered if that is just an accident.

Mr. Morton: No, I don't think that that is an accident.

In Exhibit No. 11 there is a definite locking action, where here there is not necessarily a definite locking action.

* * * * *



J. SCHILDT - PATENT No. 2,687,737 — AUGUST 31, 1954 - FILED JAN. 19, 195[illegible]

DEFENDANT'S EXHIBIT ZZ

SUBJECT INDEX

PAGE

I.

Introduction 1

II.

Statement of the case 3

III.

Argument 5

Defendant's argumentative assertions concerning "complete monopoly," transfer of "competing patent" and "no prospect" of "other circuit" litigation are without support in the record and incorrect 5

Defendant's questions concerning a mandate for a "relaxed standard of invention" and "commercial success" as the premise for patentability are not raised by the decision of the Circuit Court in this case 6

The claim in suit is not invalid for failure to claim the invention 9

The prior art fails to disclose the gist of the patented invention which is in its spur and socket construction and cooperative relation thereof with the clip closing means 10

Defendant's clear infringement was found by both courts below 12

The Court of Appeals was entirely justified in drawing legal inferences from uncontradicted evidence without remanding the case to the District Court 14

Conclusion 16

TABLE OF AUTHORITIES CITED

CASES

	PAGE
Altoona Theater v. Tri-Ergon Corp., 294 U. S. 477	9, 10
District of Columbia v. Pace, 320 U. S. 698	15
Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147	7
Keller v. Adams-Campbell Co., 264 U. S. 314	2
Lyon v. Bausch & Lomb Optical Co., 224 F. 2d 530	8
Permutit Co. v. Graver Corp., 284 U. S. 52	7
Ridings v. Johnson, 128 U. S. 212	15
Temco Electric Motor Co. v. Apco Mfg. Co., 275 U. S. 319	10
United States v. United States Gypsum Co., 333 U. S. 364	15
Virginian Ry. Co. v. United States, 272 U. S. 658	15
Waialua Agricultural Co. v. Maneja, 216 F. 2d 466	14

RULES

Federal Rules of Civil Procedure, Rule 52(a)	15

STATUTES

United States Code, Title 29, Sec. 201 et seq.	14
United States Code, Title 29, Sec. 210	14
United States Code, Title 35, Sec. 103	8, 9
United States Code, Title 35, Sec. 112	9

IN THE

Supreme Court of the United States

OCTOBER TERM, 1960
No. 874

THE I. LEON CO., INC.,

Petitioner,

vs.

KENNETH REINER and FRANK A. KLAUS, JR., doing business as THE KAYNAR COMPANY, and KAYNAR MFG. CO., INC.,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI.

To the Honorable Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

I.
INTRODUCTION.

Defendant, petitioner, misconceives the reviewing function of this Court and overlooks the necessity for alleging in his petition "special and important" reasons for this Court to grant certiorari. This case is an ordinary patent case involving the usual issues of infringement and validity, and no more. As in a hundred other patent cases, it was necessary for the court to pass on the question of whether the defendant's de-

vices came within the scope of the patent claims, and whether the claims defined invention over the prior art.

Apparently having presented both in the District Court and in the Circuit Court of Appeals for the Second Circuit, its best arguments, its best defenses and its best theories, and lost, the defendant would now seek a third round to expound them again.

There is no conflict of decision with respect to plaintiffs' patent between two Circuit Courts of Appeal, nor does this case involve any principle, the settlement of which is of importance to the public interest. This is an "ordinary patent case." As this Court said in *Keller v. Adams-Campbell Co.*, 264 U. S. 314, at 319:

> "Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent."

In the statement of "Questions Presented" defendant, petitioner, indulges in no less than eight purported questions which should be resolved by this Court. Such verbosity, we submit, serves to show not the importance of the questions but rather the inability of the defendant to frame any *one* question which is of public importance. The alleged "Statement of the Case" is neither factually supported by the record nor complete. Plaintiffs' expert did not "admit" that the spring of the patented device required a "hook" and the District Court did not so find (PA. 86a).* The dis-

*For clarity the system adopted by defendant for record designation is followed. The Appendix to Petitioner's Brief will be referred to simply as "Appendix."

tinction between the spurs and sockets of the accused device and those of the patented device now claimed to exist was not urged or found to exist by the trial court. The concurrent conclusions of the Circuit Court as to infringement also should be noted, wherein the court said it is "plain" that the claim in issue reads on defendant's clamp.

In the ensuing 40 pages of "Argument" there follows a dreary rehash of each and every contention made by the defendant below plus a scenario made up wholly out of the defendant's imagination concerning the actions of the Court of Appeals for the Second Circuit.

Respondents do not wish this Court to believe that we agree with petitioner as to the substance or correctness of any of its purported questions, and therefore hasten to deny that there are any "special and important" reasons that should cause this Court to exercise its sound judicial discretion to grant certiorari under Rule 19. In the following discussion we shall as briefly as possible dispose of the defendant's questions, combining them where possible. Some amplification of the petitioner's "Statement of the Case" to bring the subject into clear focus is preliminarily in order.

II.
STATEMENT OF THE CASE.

After a full trial the District Court held:

> ". . . that the Reiner Reissue Patent in suit is invalid, as not disclosing patentable invention over what was known to the prior art. . . ." (PA. 97a).

The court also held:

> "It is found that the Reissue Claims do not illegally broaden the claims as stated in the original patent." (PA. 99a).

On infringement the court held:

> ". . . I am of the opinion that the accused structure is an infringing device of the plaintiff's patent, and would so find if the plaintiff's patent were valid." (PA. 100a.)

Both of the defendant's counterclaims for alleged unfair competition and for alleged monopoly in the trade and commerce of a two-piece clip were dismissed (PA. 101a.) The appeal taken by the plaintiffs to the Court of Appeals was limited to the sole question of whether the trial court had erred in finding the patent invalid (PA. 104a). No cross appeal was taken by the defendant. Thus, the only issue which was before the Circuit Court and which could properly be brought before this Court is that raised by the plaintiffs' appeal.

After the decision of the Circuit Court, petitioner filed an elaborate petition for a rehearing with the Circuit Court of Appeals for the Second Circuit (Appendix II, pp. ix through xxviii). This petition was denied (Appendix III p. xxix). Petitioner also filed a petition for a rehearing en banc (Appendix IV, p. xxx), which was denied with the concurrence *of all* of the active judges except Judge Clark. All of the arguments which petitioner presents here were presented in the petitions for rehearing below. It is significant that they did not convince a strong majority of the Circuit Court.

III.
ARGUMENT.

Defendant's Argumentative Assertions Concerning "Complete Monopoly," Transfer of "Competing Patent" and "No Prospect" of "Other Circuit" Litigation Are Without Support in the Record and Incorrect.

In its argument defendant commences by raising from the grave a portion of the transcript in the trial court which allegedly supported defendant's second counterclaim for unlawful monopoly of trade and commerce (D. Br. p. 11, and Appendix XI, pp. xlviii to lvi). The cited testimony concerning the settlement or earlier litigation between the plaintiffs and Solo Products Corporation was introduced at the trial in support of said second counterclaim. In its decision the trial court said:

> "Again the testimony and argument have been considered, and the conclusion reached is that the second counterclaim also is dismissed for failure of proof." (PA. 101a).

No appeal was taken, and the cited testimony was not part of the record before the Circuit Court. In view of this, it seems obvious that defendant cannot now at this late date revive any contention concerning monopoly in the trade and commerce of two-piece clips.

According to the defendant this is again an issue because the Circuit Court in its decision referred to plaintiffs "almost complete monopoly of the 'two piece clips in the market.'" (Appendix I, p. v.) A reading of the court's statement in context indicates that it was referring to plaintiffs' phenomenal sales vol-

ume and growth and was not inferring any illegal or inequitable monopolistic practices.

Defendant's assertion, "Thus there appears to be not the slightest possibility that validity of the suit patent ever will be tested in any other Circuit," is based on the false and unproven premise that plaintiffs have no competitors. As a matter of fact, there are other competitors in the field and they do business in many other Circuits. This alleged reason for granting certiorari simply has no merit.

Defendant's Questions Concerning a Mandate for a "Relaxed Standard of Invention" and "Commercial Success" as the Premise for Patentability Are Not Raised by the Decision of the Circuit Court in This Case.

The defendant's position is based on the assertion that the Circuit Court erred because:

> ". . . the decision below makes 'commercial success' the major premise." (D. Br. p. 12.)

This assertion we believe should be contrasted with the deliberate reasoning of the court speaking through Judge Learned Hand:

> "We are of course acutely aware of the constant reminder in the books that the sale of a patented device is not alone a measure of its invention and *we accept that conclusion.*" (Appendix I, p. v) (Emphasis added.)

That the Circuit Court did not make commercial success its "major premise" is clear from its reasoning.

Moreover, defendant cannot quarrel with the statutory definition of invention (Sec. 103, Title 35, U. S. C.) used by the court in testing invention and thus defendant is reduced to disagreeing with the conclusion reached by the court on the basis of the prior art before it. Petitioners in patent cases always do disagree with the conclusions of the court below on invention, but this is no ground for raising a problem of importance to the public as distinguished from that of the parties.

In a deliberate exaggeration, defendant contends that the decision here has the effect of overruling a line of Supreme Court cases commencing with *Permutit Co. v. Graver Corp.* (1931), 284 U. S. 52, and ending with the *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.* (1950), 340 U. S. 147. None of these cases ever held that "a new concourse" of elements cannot constitute an invention. True, this Court said in the *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.* case, 340 U. S. 147, at 152:

> "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements."

But the Court also acknowledged in the same case at 151:

> "The concept of invention is inherently elusive when applied to combination of old elements. This, together with the imprecision of our lan-

guage, have counselled courts and text writers to be cautious in affirmative definitions or rules on the subject.[6]"

"[6]With respect to the word 'invention,' Mr. Justice Brown said: 'The truth is the word cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. In a given case we may be able to say that there is present invention of a very high order. In another we can see that there is lacking that impalpable something which distinguishes invention from simple mechanical skill. Courts, adopting fixed principles as a guide, have by a process of exclusion determined that certain variations in old devices do or do not involve invention; but whether the variation relied upon in a particular case is anything more than ordinary mechanical skill is a question which cannot be answered by applying the test of any general definition.' *McClain v. Ortmayer*, 141 U. S. 419, 427, 12 S. Ct. 76, 78, 35 L. Ed. 800."

Nothing in the decision of the Circuit Court would warrant the conclusion that they are in any way attempting to deviate from the spirit of the inventive test set forth by Congress and this Court. On the contrary, the decision reflects a conscientious effort to properly apply the test to the fact situation presented here.

Defendant also cites a number of different Circuit Court cases which have commented on Section 103, Title 35—whether or not it is intended to change the standard of invention to be applied. The Second Circuit Court of Appeals speaking through Judge Learned Hand in *Lyon v. Bausch & Lomb Optical Co.*, 224 F. 2d 530, is said to represent one view; while several of the other Circuits are said to have an entirely different view. These different views are alleged to create a dispute of which this Court should take cognizance.

We submit that no real and substantial differences exist since all the Circuits agree that Section 103, Title

35 sets forth the only accepted definition which *all* are applying. Moreover, all of the Circuits agree that the intent of Congress in adding Section 103 was as is set forth in the Senate Report, for "uniformity and definiteness." It is to be expected that in particular fact situations the application of the test will be questioned by the losing party. In the words of this Court the "concept of invention is inherently elusive". This is not to say that this Court should take jurisdiction of the ordinary patent case in which the test is applied.

The Claim in Suit Is Not Invalid for Failure to Claim the Invention.

Defendant seeks to create a conflict between the case here and the decision of this Court in *Altoona Theater v. Tri-Ergon Corp.*, 294 U. S. 477, where the claim was held to be invalid because the patentable relationship relied upon was not specified in the claim. Here, the claim in issue defines the means for forming the rocking connection as:

> ". . . correlated means integral respectively with said plates, including spur means integral with one of said plates, and socket means on the other plate receiving the spur means, and cooperating therewith to hold said plates against shifting relatively to each other, and forming a rocking connection between said plates. . . ."

It is thought obvious that the cooperative relationship between the spurs and sockets and their relationship to the plates is distinctly set forth.

Moreover, Section 112, Title 35, U. S. Code contains the following provision:

> "An element in a claim for a combination may be expressed as a means or a step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claims shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

When the claim is read in the light of the specification and drawings (PA. 174a) the exact preferred construction of the "spur means" and "socket means" is found to be set forth in detail. This should always be done in construing a claim as was said by this Court in *Temco Electric Motor Co. v. Apco Mfg. Co.*, 275 U. S. 319, at 350.

Nor is there any merit in defendant's contention that the saving of material which is accomplished by the use of the patented invention must be referred to in the specification and claims. The beneficial result if stated would be purely functional and thus immaterial. The *Altoona Theater* case is simply inapposite.

The Prior Art Fails to Disclose the Gist of the Patented Invention Which Is in Its Spur and Socket Construction and Cooperative Relation Thereof With the Clip Closing Means.

What defendant fails to state in its Brief is that the spur and socket construction and the cooperative relation thereof with the clip closing means found in the patented invention and in the defendant's clamp is *not* found in the prior art.

In its "Montage of Prior Art" (Appendix IX) the defendant has produced its "best" or closest prior art

patents. Lindsay 2,031,377 and Jones 2,133,145. Neither of these patents teaches plaintiffs' spur and socket construction and in the lower hypothetical structure (which defendant says represents the suit patent) it is significant to note that the ears of Lindsay, erroneously called spurs, are bent outwardly around the other clamp member. There is no suggestion of sockets formed to receive spurs and form a rocking connection.

As Judge Hand said:

> "Jones's patent, 2,133,145, is the nearest of all those offered, but the lower member, 11, is kept in register with the upper member, 10, by means of the 'side flanges, 17,' which requires the upper member to be different from the lower, and the use of more metal than the spur and socket device of the patent in suit. Moreover, the closing spring is altogether different." (Appendix I, p. vii).

The remainder of the prior art mentioned by the defendant is of even less significance. Cahn 769,336 (PA. 190a) has an entirely different type of spring which requires the use of a hinge construction which will hold the clamp member together. This distinction was recognized by the trial court Judge Byers (PA. 76a) contrary to the defendant's assertions. Likewise, Lindsay 2,031,377 (PA. 198a); Atchley 1,591,732 (PA. 194a); Halket 1,387,978 (PA. 192a) and Turnor British Patent No. 10,972 (PA. 182a) all have spring arrangements which are totally incompatible with the use of spurs and sockets for a rocking connection. In all of these devices the clamp members must be positively held together against the action of the spring.

Viewed in this light it is clear that the fact situation here is one in which the best of the prior art fails to disclose the novel construction of the patented device. The defendant on the other hand does not make use of either the Lindsay or the Jones structure; it uses the correlated "spur means" and "socket means" and the "resilient integral extension of bow-form . . . extending around the axis of said rocking connection, engaging the other plate. . . ." called for by the claim in issue.

Defendant's Clear Infringement Was Found by Both Courts Below.

Defendant argues that it does not infringe because its spurs are provided with barbs and "Its barbs have no correlative in the suit patent" (D. Brief, p. 31). Nothing is more clear than the fact that the addition of elements does not avoid infringement. Moreover, in this case the evidence showed that the defendant's clamps were fully operable and functioned in the same way as the patented clamps with the "barbs" removed. Plaintiffs' expert Stam testified that he removed the "barbs" from defendant's clamps and found that they were fully operable and held together by the spring. This was not disputed. (P. Supp. Appendix, pp. 3a. 4a.)

Defendant's second contention is that it does not infringe because its spring passes through the other handle and presses down rather than pulls up as in the preferred form of the patented device. That very contention was answered by District Judge Byers:

"This question turns upon whether the defendant's spring which is integral with the lower clamp-

ing member and extends forward through an opening in the handle of the upper member and rests upon a portion of that member, is within the teaching of the plaintiff's patent.

"It has already been stated that the claims in suit are broad enough to cover a spring integral with either (2002) member and otherwise performing the functions peculiar to it. In view of the preferred embodiment of the plaintiff's patient in which the spring is integral with the upper member having its engagement at the end in a hook as has been explained, the defendant argues that the plaintiff's structure is necessarily confined to a spring, the engagement of which is accomplished by the hook, and does not cover a spring which merely rests upon a portion of the upper member to accomplish its purpose.

". . . I am of the opinion that the accused structure is an infringing device of the plaintiff's patent, and would so find if the plaintiff's patent were valid." (PA. p. 99a.)

Also it was answered by Circuit Judge Hand:

"The other defenses do not require any extended discussion. It is plain that the reissued Claim three did not enlarge the scope of the invention. It is also plain that its language reads, not only on the specifications, but upon the defendant's 'clamp.' The distinction suggested that the 'resilient integral extension,' *i.e.* the spring, pulls instead of pushes, the members together as in the defendant's 'clamp' is irrelevant. Claim three does not contain as an element either method, and covers both." (Appendix I, p. viii.)

There was no error on the part of either of the courts below in finding that the defendant's clamp came within the scope of the claim in issue.

The Court of Appeals Was Entirely Justified in Drawing Legal Inferences From Uncontradicted Evidence Without Remanding the Case to the District Court.

In the last of its purported questions the petitioner has asked this Court to grant certiorari because of the alleged error of the Court of Appeals in making findings of fact on the issues of "commercial success", "long-felt want", and "the savings of metal". The apparent thrust of this argument is that by failing to remand the case to the District Court in order to obtain findings on these evidentiary matters the Court of Appeals has so far departed from the usual course of judicial proceeding as to require the supervisory jurisdiction of this Court.

The petitioner has cited the case of *Waialua Agricultural Co. v. Maneja*, 216 F. 2d 466, 474 (9th Cir., 1954), in support of an assertion that the court's conduct was "forbidden by statute". This argument is completely misleading.

In the *Waialua* case, the action was brought under the Fair Labor Standards Act, 29 U. S. C. 201 *et seq.* By a specific provision of that Act (29 U. S. C. 210), the court review of a determination of the Wage and Hour Administrator is specifically limited to questions of law. This is a far different matter than the scope of review as to "undisputed evidentiary facts" in an equity case.

The decisions of this Court are sufficient to indicate that petitioner's argument is totally without merit.

The case in the District Court was in the nature of a suit in equity and accordingly tried before a judge without a jury. From time immemorial, the scope of appellate review of an equity action has been much broader than a writ of error from a jury verdict in an action at law and can include determinations of fact. *Virginian Ry. Co. v. United States*, 272 U. S. 658, 675. See also *District of Columbia v. Pace*, 320 U. S. 698, 701.

In *Ridings v. Johnson*, 128 U. S. 212, 218, Mr. Justice Bradley said:

> ". . . on an appeal in an equity suit the whole case is before us and we are bound to decide it so far as it is in condition to be decided."

The present appellate practice under the Federal Rules of Civil Procedure, Rule 52(a) is authoritatively set forth in *United States v. United States Gypsum Co.*, 333 U. S. 364, 394 (1948). The traditionally broad scope of equity review was there made applicable to all actions tried upon the facts without a jury, particularly when the fact finding pertains to inferences drawn from documents or undisputed facts.

In the present action, the evidence pertaining to commercial success, long-felt want, and savings of metal was undisputed in the trial court and, indeed, is undisputed by petitioner's lawyer in his brief. The Circuit Court did not dispute any specific fact findings of the trial court, but merely disputed the legal consequences of the evidence. Such appellate action occurs every

time a trial court is reversed. Accordingly, by itself, such action cannot serve as grounds for a writ of certiorari.

Conclusion.

We do not believe that this Court would wish that we fully argue in this brief the merits of the patent in suit over all of the prior art cited and discussed in the trial court.

We have attempted to show that the issues involved here are the usual ones of validity and infringement. The applicable statutes were applied, and on its merits the patent found valid over art which is clearly distinguishable.

Since the petitioner has lost, it seeks to create something special which would warrant judicial review by this Court. The questions it poses do not find support in the record below, nor in the decisions of the District or Circuit Courts. In grasping for the special and important reasons which would raise this case from the status of a mundane patent case, petitioner has muddled together eight compound and complex questions. Upon careful scrutiny these questions fail to define any clearcut issues which warrant this Court's review.

Respectfully submitted,

ROBERT W. FULWIDER,
JOHN M. LEE,
Attorneys for Respondents.

WILLIAM R. LIBERMAN,
Of Counsel.

Los Angeles, California, May 1, 1961.

IN THE

Supreme Court of the United States

October Term, 1960

No. 874

THE J. LEON CO., INC.

v.

[illegible] REISNER and FRANK A. KEATS, JR.
trading as THE KAYNAR COMPANY and
KAYNAR MFG. CO., INC.

Petition for Rehearing of Order Denying Petition for Writ of Certiorari to the United States Court of Appeals for the Second Circuit and Affidavit in Support Thereof

---

[illegible]

INDEX

	PAGE
Basic Facts	1
Argument	3
Conclusion	8
Clerk's Certificate	8
Affidavit of Louis Leon in Support of Petition for Rehearing of Petition for Writ of Certiorari to the United States Court of Appeals for the Second Circuit	9

CASES CITED

Hyde Park Clothes v. Hyde Park Fashions (C. A., 2 Cir.), 204 F. 2d 223	6
Langdon v. Saltser & Weinsier, Inc., 175 F. Supp. 96	5, 6, 7
Lyon v. Bausch & Lomb Optical Co., (C. A., 2 Cir.), 224 F. 2d 530, certiorari denied 350 U. S. 911	2, 7
The Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp. (1950), 340 U. S. 147	2, 5

STATUTE CITED

Act of 1952, 35 U. S. C. 103	2

IN THE

Supreme Court of the United States

OCTOBER TERM, 1960

No. 874

THE I. LEON CO., INC.,

Petitioner,

v.

KENNETH REINER and FRANK A. KLAUS, JR., doing business as THE KAYNAR COMPANY, and KAYNAR MFG. CO., INC.,

Respondents.

Petition for Rehearing of Order Denying Petition for Writ of Certiorari to the United States Court of Appeals for the Second Circuit

Your Petitioner, The I. Leon Co., Inc., respectfully prays for a rehearing of the Order of this Court, dated May 22, 1961, denying its Petition for a Writ of Certiorari to the United States Court of Appeals for the Second Circuit.

Basic Facts

This is an action for patent infringement, which was tried before the United States District Court for the Eastern District of New York, and judgment was there entered for Defendant, Petitioner herein.

On appeal by Plaintiffs to the United States Court of Appeals for the Second Circuit, the judgment was reversed, and the patent, which previously had been held invalid, was held valid by a divided court, rejecting the reasoning by the District Court based upon *The Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.* (1950), 340 U. S. 147. Two judges voted to reverse, and to hold one claim of the patent valid, upon the basis that Congress, as the Court read the Act of 1952, 35 U. S. C. §103, had required a new relaxed standard of invention, and in accordance with the argument in *Lyon* v. *Bausch & Lomb Optical Co.*, (C. A., 2 Cir.), 224 F. 2d 530, certiorari denied 350 U. S. 911, extending the rule to the point that commercial success was sufficient to find invention, even though the elements upon which the Court found invention were not present in the claim, reading the claim as if it contained those elements. One judge voted to affirm Judge Byers' decision of the Eastern District Court on the basis that the claim was invalid.

Petitioner, Defendant, is located in a small town on Long Island. Petitioner is the largest employer in that community, and presently employs between thirty-five and forty people, with a payroll of about $150,000.00 per year. The decision in this case means hardship for the people in the community, not only for the employees, but also for the merchants and others who depend upon such employees for their livelihood. These people either support a family, or help to support a family, with their earnings. By their loss of employment, they will inflict a sharp burden upon the community which the State will have to assume by unemployment insurance, or by relief.

Petitioner has been located in the community since 1943. Also it has shown that the development of Plaintiffs' business is completely unrelated to the invention.

but arose from circumstances such as the surge of hoarding which arose as the Korean War began, with the threat of controls and shortages.

Furthermore, there has developed a conflict within the decisions of the Court of Appeals for the Second Circuit in light of the decision handed down by that Court on a patent subsequent to the decision in the case here, and just immediately prior to the filing of the Petition for Writ of Certiorari in this case, but before such decision was brought to the attention of Petitioner here.

Argument

Petitioner assigns the following reasons for granting this Petition:

Petitioner desires to make it clear that it well understands that certiorari is a matter of grace so far as such review is granted by this Court. On the other hand, it is respectfully prayed that the Court will consider the implications arising from the decision below, where the decision of a divided Court, and over the express request by Judge Clark of that Circuit for a rehearing *in banc*, is permitted to stand and wipe out the livelihood of a good portion of the town of Massapequa, New York, where, even before this case, and contrary to the protestations of Plaintiffs, but in accordance with the findings by Judge Learned Hand, Plaintiffs have maneuvered to establish themselves as almost a complete monopoly in this industry. It is submitted that, even at first glance, further scrutiny of this situation is required to seek an answer to the question, not merely on the naked question of patent law, but on the further pertinent question, is justice being done in a case such as this by permitting the decision of the Court of Appeals below to become the

judgment in this case, contrary to the finding of Judge Byers and the positive statement by Judge Swan, that Judge Byers should be affirmed, and the request by Judge Clark that the case should be heard *in banc* to remove the effect of the decision by the two senior judges, particularly in light of the facts here presented, that the rights not merely of Petitioner are being taken away by this reversal, but the rights of this entire community are being taken away by the vote of one judge on the basis of a doctrine for which there is no authority in this Court, or any other Circuits.

The decision of the Court below assumes as fact that which was not proved in the case here. As shown by the accompanying affidavit, the facts of the situation are, as most probably known to the members of this Court, that the Korean conflict which ensued after the alleged invention of the suit patent, created an unexpected market for anything of metal, as merchants and speculators looked forward to the bonanza of having hoards of materials in short supply on which to make their fortunes. But that bubble burst, and those who had clips had to get rid of them, or face bankruptcy. They did get rid of them, and clips penetrated the market. And with it came the days when a woman no longer could afford to hire help for her hours, but did find ways to do things herself so as to stretch her income for what she considered her needs. And hair dressing was one of those necessities. That meant that something as expensive as a beauty parlor, in many cases, was out of the question, so the result was hair setting at home. Thus the basic reason for patentability in the decision of the Court of Appeals below, that there was commercial success, fades out when the actual facts appear, that the commercial success arose from the incidents of the Korean War with the increase of do-it-yourself.

But there are other reasons why, it is submitted, this Petition should be granted.

Since the decision of the Court below, where the decision of invalidity of the District Court on the basis of aggregation, founded in the *A. & P.* case, was upset by Judge Learned Hand's reasoning as to the alleged mandate from Congress for a relaxed standard of invention, that same Court itself obviously has not followed Judge Learned Hand's rule. In *Langdon* v. *Saltser & Weinsier Inc.*, 175 F. Supp. 96, Judge Zavatt, in the United States District Court for the Eastern District of New York, held, just as did Judge Learned Hand in the case here, that where a device satisfies an old and recognized want, invention is to be inferred, rather than the exercise of mechanical skill. Judge Zavatt also found that the mere accomplishment of the same result is insufficient to find infringement, even if the claim literally reads, that where there is a change in principle from the patented device, that should be considered in defeating the charge of infringement.

The same Court of Appeals, in a still unreported decision, October Term, 1960, Docket No. 26139, in the case argued on February 8, 1961, on appeal from Judge Zavatt's decision, after the decision of the present case, and decided on March 14, 1961, made no reference at all to the present case for its rule. But the Court there held the patent *invalid* upon the basis of the same patents specifically discussed by Judge Zavatt in the District Court, and over which the District Court had held the patent there in suit valid.

In that case, the prior patent had issued *more than twenty years* prior to the original application of the patent there in suit. This did not impress the same Court of

Appeals in that case, even though it had impressed the District Court there. Yet, in the case here, the same Court made much of the fact, in fact based its decision upon the fact, that supposedly from 1932 to 1946, there had been a failure of the art to reach the conclusion of the suit patent's idea, and thus the Court found a "long felt want was being filled" even though there was no evidence to that effect except the prior art itself. In the case here, there was no finding by the District Court as to a long felt want. But in the *Langdon* case, there was an express finding by the District Court, that there had been a "long felt want". Thus, there is this conflict of decision within a few months, in the same Court, on this question as to whether long felt want is a basis for patentability. It is submitted that this requires correction in the present case particularly in view of the effect upon the economic status of the innocent bystanders in the case at bar. It should not be, as Judge Clark said in *Hyde Park Clothes* v. *Hyde Park Fashions* (C. A., 2 Cir.), 204 F. 2d 223, that the decision of the case should lie merely in the caprice of the selection of the panel.

Also, in the *Langdon* case, the reissue patent there was held *invalid* on the basis that the claims submitted in the reissue, although condemned in the reissue oath as being inoperative, insufficient and defective, still were retained. In the case here, before the Court of Appeals, the same premise was laid down to sustain the same conclusion, that the reissue patent, which was the suit patent in the case here, was invalid because the reissue oath declared one thing, but the claims submitted and obtained were contrary to that reissue oath. The Court of Appeals, in its opinion in the *Langdon* case (p. 1027 of its own bound opinions) says:

> "We are of the opinion that such an oath is not to be taken lightly, and that Langdon is estopped

> to disregard his former contention that the claim in suit does not clearly distinguish from the prior art."

Yet, in the case here, the same Court of Appeals rejected the very same basis for a holding of invalidity of the suit claim. This statement was made to the Court of Appeals in the instant case, that

> "* * * The reissue oaths (D. 72b, 77b) lay a basis for the reissue in the fact that the suit patent's spring was in a form which curved *forwardly around* the axis upon which the plates rock. Despite this statement in the reissue oath, that this was the reason why reissue was sought because the claims did not so define, the suit claims are not so specifically limited."

Yet, despite these statements, the Court of Appeals, which later held the reissue oath could not be taken lightly, in the instant case refused to give weight to the fact that the statements made the basis for the reissue should have such weight.

Furthermore, the arguments in the reissue oath were held sufficient, in the *Langdon* case, to estop the patentee from asserting breadth of claim sufficient to include that which, by the argument in the oath, was excluded, although the express words of the claim did not exclude. Yet here, that same basis was urged and set forth in full, but summarily set aside because of the doctrine of the *Bausch & Lomb* case, which certainly should have had as much bearing in the *Langdon* case, as it was considered to have in the present case.

CONCLUSION

For the foregoing reasons, Petitioner respectfully prays that the Order of this Court, denying its Petition for a Writ of Certiorari to the Court of Appeals for the Second Circuit, be reheard and vacated, and the Petition be granted.

Dated: New York, New York,
June 14, 1961.

Very respectfully submitted,

HENRY L. BURKITT,
Attorney for Petitioner,
Defendant-Appellee,
Office and Post Office Address,
19 West 44th Street,
New York 36, New York,
MUrray Hill 2-7498.

Certificate of Counsel

The undersigned, HENRY L. BURKITT, Attorney for Petitioner, hereby certifies that the Petition for Rehearing filed in this cause is presented in good faith, that in his judgment said Petition is restricted to the grounds specified in paragraph 2 of Rule 58, as amended, and that said Petition for Rehearing is not interposed for delay.

HENRY L. BURKITT,
Attorney for Petitioner,
Defendant-Appellee.

Affidavit of Louis Leon in Support of Petition for Rehearing of Petition for Writ of Certiorari to the United States Court of Appeals for the Second Circuit

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1960

No. 874

THE I. LEON CO., INC.,

Petitioner,

v.

KENNETH REINER and FRANK A. KLAUS, JR., doing business as THE KAYNER COMPANY, and KAYNER MFG. CO., INC.,

Respondents.

State of New York
County of Nassau—ss.:

LOUIS LEON, being duly sworn, deposes and says:

1. I am Secretary and Treasurer of The I. Leon Co., Inc., Petitioner, Defendant herein. I am fully conversant with the facts in the case heretofore presented, and with the facts regarding which I am making the present statement.

2. The business of Petitioner was established a number of years ago. Since 1943, the business has been located in Massapequa, Long Island, New York. Our business has, in large measure, been directed to supplying

the professional beauty parlor trade, as against the lay persons who set and dress their own hair. My father before me, and now my brothers and sister and myself, have operated the present business, and have sought to create a market for our hair clips in the field of professional beauticians, who own their beauty parlors, and who have to meet special problems in their work.

3. For instance, our company owns Letters Patent Nos. 2,467,487, issued April 19, 1949, on the application of Leonardo I. Leon, filed April 6, 1944, D. Ex. S, and Des. 138,901, issued September 26, 1944, on the application of Leonardo I. Leon, filed August 1, 1944, D. Ex. R. Both of these patents were issued for hair clips, and the patents were issued to my father, since deceased. These clips are identified in the trade as the "Colanite" clip. As the record below shows, these clips were made of aluminum, with a rubber member to serve as the spring for closing the jaws of the clips together. The reason why aluminum was used for the "Colanite" clip, and not the steel of the clips of the suit, is because the solution used by beauticians chemically attacks steel, and causes discoloration of the solution, and thereby of the hair itself. Aluminum is non-reactive with such solution. Beauticians, who long had used nothing but enameled hairpins or so-called bobby pins, turned with great reluctance, and only after considerable sales pressure on our part, to the use of the aluminum "Colanite" clips, as against bobby or hair pins.

4. Our organization it was which did the pioneer work to build up a very extensive business among beauticians for the aluminum clips. At one time, we employed one hundred five people just for the manufacture and sale of that one clip. We were first in the field, and we converted the beautician to the use of these aluminum clips.

This clip is the clip to which Reiner, one of the Respondents, referred in his testimony as being that to which he had referred, which he had in front of him, when he designed the clip for which he then sought Letters Patent, the suit patent.

5. As I have said above, our organization is located in a small town, Massapequa, on Long Island. Our staff of thirty-five to forty employees means, in many cases, that many complete families rely upon single wage earners. We have a payroll of about One Hundred Fifty Thousand ($150,000.00) Dollars a year. That means a great deal in a community like ours. The loss of a job by each of these wage earners will mean a tightening of the belt in this community by each of those families. It will mean not merely the loss of a job by this wage earner. It will mean the loss of earning power on the part of a group of merchants who live off these wage earners who deal locally for their various needs. Our organization, I believe, is the largest single employer in the community. We employ four salesmen who go out to get the business for our concern. The result in the case here, in which Judge Byers' decision has been upset by the two to one decision in the Court of Appeals, will require us to close our doors, and throw these people out of work.

6. We were selling the "Colanite" clip for Four ($4.00) Dollars per hundred when the clip of Plaintiffs, Respondents herein, first came on the market in 1948. Plaintiffs, who had no experience in the beauticians' field, sought to undersell the "Colanite" clip, first pricing their clip at Three Dollars and Fifty ($3.50) Cents per hundred. The beauticians refused to have anything to do with Plaintiffs' clip. The steel contaminated the permanent waving solution.

7. Plaintiffs then dropped their price in successive stages as they sought to penetrate the field. They dropped their price from $3.50 down to Two ($2.00) Dollars per hundred, but still could not get the beautician to accept the steel clip.

8. Then came the Korean War. When the announcements came out of Washington, indicating the possibility of re-establishing the controls over metals which had been in effect during World War II, with the shortages thus created, and with the remembrance of those conditions, the sale of hair clips reached tremendous proportions as the supply houses bought without relation to immediate needs of the market, in order to have these clips on hand for sale after the expected restrictions went into effect.

9. Then came the realization that no controls were to be imposed. There was no shortage. Those who had bought clips to hoard them found themselves with inventories which they had to dump. Extreme salesmanship then ensued to make the markets for these hoarded clips. That was the reason for the great volume of sales shown at that time.

10. Plaintiffs never got more than $2.00 per hundred for their clips in this period, and up to June, 1950. In the meantime, our "Colanite" clip dropped in price only to $3.50 per hundred.

11. Our concern created the market for the aluminum clip in the beauticians' field, as distinct from the general do-it-yourself market of the drugstore and the five and ten cent store, in which Plaintiffs' clips found their greatest market. Beauticians still will not use the steel clip, even ours, but the beauticians still buy the "Colanite" clips. The public itself, turning to do-it-yourself, could

get their clips on the five-and-ten cent store counters where there are massive displays of every possible means for hairdressing, including curl makers, holders, and many other different kinds of hair waving devices and solutions.

12. In our organization, we had a steel clip long before we entered upon the production or filed application for Letters Patent therefor. We were always well aware of the reasons why the beauticians were antagonistic to the steel clip. We did nothing to bring the steel clip upon the market since my father before us, and we, have devoted ourselves to developing the market in the field of the beautician who at that time was the greatest outlet for beauty items.

13. Contrary to the statement in Judge Learned Hand's opinion, the hair clips sold in the five-and-ten cent store to the general public is not considered a reusable item. Their sales would hardly be very much if the first sale would be the only sale. It is because the clip has a very short life that the sales have increased as the general public has turned more and more to acting as its own beautician in the setting of hair. On the other hand, in the case of the "Colanite" clip, the replacement of those clips by the beautician is a steady amount, as the clips wear out from continued use, day by day, in the beauty shops. The cost of such clips is an important item to the beautician, and they attend to saving clips for successive use. It is too well known to require repetition here, that the complete setting of the hair is performed in the beauty parlor so that, when the woman walks out, she does not carry a load of metal upon her head, something which can be seen on the heads of the many girls as they parade around the streets with a mass of hair clips on their heads after they themselves have

"set" their hair. The beautician sees to it that he reclaims the clips from the hair, and that his work is completed, by the time the client walks out. Thus there is constant reclaiming of the aluminum clips, and the return of those clips to repeated use in a beauty parlor, while the girl who takes her clips to her office with her, does not necessarily see to it that she returns those clips home again.

14. At the present time, our business requires the sale of the steel clips which we designed without relation to the clip which Plaintiffs had marketed, in order to retain and employ the staff which presently operates our plant.

15. Our development of our clip was in no way related to the clip of Plaintiffs. Our concept had nothing to do with any hooking of the two members together, as is quite apparent from the comparison of the two clips, as discussed in the briefs. We used positive action to hold the two plates together. We knew how it had been usually done in the past to press the plates of clips together by a positive spring, without the use of a hook. And we knew how spring plates were held positively against separation by means of ears and trunnions. We tried a clip such as ours, first without the barbs. We found that if pressure were applied in a certain way, the clip plates might jump apart. We then did what the prior art showed us. We formed ears and trunnions, turned inwardly from one plate to engage over the other plate, as the trunnions engage in the ears of previous clips. None of this was in the suit patent. After we got our barbs working, nothing could separate the plates of the clips. Our first development, made by our toolmaker, was not marketed because we could not get the proper response from the beauty parlors. We could not even

consider building up the public to "do your own hair" with the use of such clips as this necessarily would have antagonized the source of our most lucrative business.

16. I state these facts to show that the alleged commercial success of Plaintiffs' clips had absolutely nothing to do with their invention. We had the clip to market, but we could not make a market for them because of the refusal of the beautician to use a steel clip. When the Korean War made anything marketable, and Plaintiffs' clip got on the market, under the circumstances I have set forth, and do-it-yourself became the practice of increasing numbers of people who did not use beauty parlors, we brought our first clip on the market, and then, when the plates would jump apart, we went to the clip which used the trunnion-ear formation of the prior art, a structure for which there was not the slightest suggestion in the suit patent.

LOUIS LEON

Sworn to before me this
10 day of June, 1961.

MARGARET HAYDEN
Notary Public,
State of New York
No. 30-1717890
Qualified in Nassau County
Term Expires March 30, 1963

(SEAL)

Office-Supreme Court, U.S.
FILED
JUN 16 1961
JAMES R. BROWNING, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1960

Docket No. 874

THE I. LEON CO., INC.,

Petitioner,

v.

KENNETH REINER and FRANK A. KLAUS, JR., doing business as THE KAYNAR COMPANY, and KAYNAR MFG. CO., INC.,

Respondents.

ADDENDUM

for Petition for Rehearing of Order Denying Petition for Writ of Certiorari to the United States Court of Appeals for the Second Circuit

An important additional fact has developed since the printing and forwarding of the Petition for Rehearing, which fact, it is submitted, will be found to be of great importance on the determination of the Petition for Rehearing.

Before the Petition for Certiorari was ready for service and filing, Petitioner sought a license from Respondents. When the Petition for Writ of Certiorari was served, Respondents requested sixty days for their Reply Brief because (a) they desired to negotiate for the purchase of

the assets of Petitioner, including the patents for the "Colanite" clip, and the patents under which Petitioner was making its steel clip, the one charged as infringement, and (b) the owners of Respondents' business had fallen out and were dividing up their assets; and the first negotiations could not be carried on until the differences between the Respondents had been resolved. Petitioner was assured that Respondents were sincere in their desires to purchase the business and assets of Petitioner.

The Attorney for Petitioner refused to consider any such extended period, and granted a short extension of time for a Reply Brief. Strangely enough, despite repeated requests for additional extensions of time right up to the last minute, the Reply Brief was served and filed before the date of the extension granted.

After the denial of the Petition for Certiorari, there was a long lapse, during which correspondence was left unanswered, until a few days ago, when a letter was received from the Attorneys for Respondents, that the negotiations were still to proceed.

At the time the Petition for Certiorari was being filed, Respondents had made what appeared to be a firm offer, which was far below the real value of the fixed assets of Petitioner. Papers were prepared, and were in the stage of being negotiated to a final agreement.

On June 14, almost at the end of the business day, Respondent Reiner called Louis Leon, the affiant of the affidavit submitted in support of the Petition for Rehearing, to make an offer which was far below the offer which Respondents had made originally, and which was completely unacceptable to Petitioner as it amounted to taking over the assets of Petitioner as if it were already defunct and bankrupt. That offer has been refused. That offer in-

cluded a provision for the taking over of the patents of Petitioner for both the "Colanite" clip, and the steel clip which Petitioner has heretofore manufactured.

Thus, Respondents have confirmed the belief that they were negotiating only for the purpose of maneuvering to destroy the possibility that the Petition for Certiorari would be granted. On the Petition for Rehearing, it is obvious that they have waited until almost the final hour for the filing of the Petition for Rehearing to "hold a gun at the head" of Petitioner.

It is respectfully submitted that these facts are important, to show that Respondents are indeed maneuvering to perfect an illegal monopoly in this field, and just as in the *Altoona Publix* case, the Writ of Certiorari should be granted to assure against the creation of any such illegal monopoly.

Very respectfully submitted,

HENRY L. BURKITT,
Attorney for Petitioner,
Defendant-Appellee,
Office and Post Office Address,
19 West 44th Street,
New York 36, New York,
MUrray Hill 2-7498.